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IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1944.

No. **151**

THE SEVEN UP COMPANY,
Petitioner,

v.

CHEER UP SALES COMPANY OF ST. LOUIS, MISSOURI,
a Corporation, AMERICAN SODA WATER COMPANY,
a Corporation, and ORANGE SMILE SIRUP
COMPANY, a Corporation,
Respondents.

PETITION FOR WRIT OF CERTIORARI
To the United States Circuit Court of Appeals
for the Eighth Circuit
and
BRIEF IN SUPPORT.

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COMPANY, a Corporation,
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PETITION FOR WRIT OF CERTIORARI

**To the United States Circuit Court of Appeals for the
Eighth Circuit.**

Your petitioner, The Seven Up Company, prays that a writ of certiorari issue directed to the Circuit Court of Appeals for the Eighth Circuit, commanding said court to certify and send to this court a full and complete transcript of the record and of the proceedings of said Circuit Court of Appeals had in the case numbered and entitled on its docket, No. 12955, Civil, The Seven Up Company, Appellant, v. Cheer Up Sales Company of St. Louis, Missouri, a corporation, et al., Appellees, to the end that this cause may be reviewed and determined by this court as provided for by the Statutes of the United States.

Your petitioner respectfully shows:

STATEMENT.

Petitioner filed its complaint in the United States District Court for the Eastern Judicial District of Missouri, (a) charging the infringement of its registered trade-mark *Seven Up*, or *7 Up*; (b) and unfair competition in dress or package, including said trade-mark; and (c) for cancellation of registration in the United States Patent Office of defendant Orange Smile Sirup Company.

A judgment of the District Court dismissing petitioner's complaint was affirmed by the Circuit Court of Appeals.

Petitioner's trade-mark is *Seven Up* (Reg. No. 252,350, R. 85), or *7 Up* (Reg. 331,345, R. 89). Respondent's accused mark is *Cheer Up* (Reg. No. 340,923, R. 95).

Marks of both parties are used on the same goods, a carbonated beverage or soft drink and extracts and ingredients therefor. The beverages are substantially identical, both being lithiated lemon lime flavor.

Petitioner's bottle is exemplified by Plaintiff's Ex. 2, while respondents' accused bottle is exemplified by Plaintiff's Ex. 1; both bottles for convenience being illustrated by color photographs included in the Appendix hereto.

Jurisdiction.

The judgment of the Circuit Court of Appeals was entered April 26, 1945 (R. 553). Petition for rehearing, timely filed by petitioner (R. 567), was denied on May 15, 1945 (R. 569).

Jurisdiction of the District Court was invoked under the trade-mark laws of the United States, and more particularly United States Code, Title 15, §§ 97 and 102, and Title 28, § 41 (7). Since the charge of unfair competition

includes trade-mark infringement and there is substantially a single cause of action, jurisdiction of the federal court is supported by *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U. S. 315, 325, 336.

Jurisdiction of this court is invoked under Sec. 240, as amended, of the judicial code, United States Code, Title 28, § 347 (a) and Title 15, § 98.

Statutes Involved.

The case involves an interpretation of the trade-mark laws of the United States and more particularly 15 U. S. C. 96, relating to infringement of trade-marks, and especially the words “reproduce, counterfeit, copy, or colorably imitate”; and 15 U. S. C. 102, relating to cancellation of registered marks, and especially the words “interfering registered trade-marks”; both sections being set out in the Appendix hereto.

Questions Presented.

A. TRADE-MARKS.

1. In the case of a registered mark comprised of two arbitrary words; is it permissible for a competitor to adopt and use on directly competitive goods, (a) a two-word mark consisting of the reproduction of one of such arbitrary words in conjunction with a substitute for the other, in manner and form so that (b) in the two marks the reproduced word occupies the same relative position?

2. Restating question 1 concretely and in terms of the record, is *Seven Up* or *7 Up* infringed by *Cheer Up*?

B. UNFAIR COMPETITION.

3. In a comparison of the general appearance of two competing packages, each appearance being comprised of a complex combination of elements that taken severally

are old, is it allowable to break up the combination by isolating and disregarding the presence of the back-ground element of both combinations, because such element (not the combination) is in the public domain, and thereupon to ground the absence of confusing similarity on the combination as so disrupted?

4. Restating question 3 concretely and in terms of the record, does the use of respondents' bottle, exemplified by Plaintiff's Ex. 1, constitute unfair competition with petitioner's bottle, exemplified by Plaintiff's Ex. 2?

REASONS RELIED ON FOR GRANTING THE WRIT.

1. An important question of federal law, involving the interpretation of the said sections of the trade-mark statutes, has been decided which has not been but should be settled by this court.

2. The said federal question has been decided in a way probably in conflict with an applicable decision of this court, *Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19, 33.

3. A question of local law, involving unfair competition, has been decided in a way probably in conflict with an applicable local decision, *McCann v. Anthony*, 21 Mo. App. 83.

Wherefore, petitioner respectfully submits its petition for writ of certiorari.

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BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

OPINION BELOW.

The opinion of the Circuit Court of Appeals (R. 545-553) is not yet reported.

JURISDICTION.

The jurisdictional statement appears in the Petition for the Writ of Certiorari.

STATEMENT OF THE CASE.

The essential facts are set forth in the Petition. Since the respective marks and packages of petitioner and respondents are used for competitive equivalent goods (lithiated lemon-lime flavored soft drinks and extracts and ingredients therefor), a decision of all the issues in the case requires only an inspection and comparison of the marks and of the packages.

A substantial record has been made but it relates largely to background, such as the history of the two marks and the make-up of the corresponding packages. These surrounding circumstances may be of importance in fixing the perspective and measuring the extent of the wrong charged, but such subordinate facts do not change the identity of the two marks or the appearance of the packages. Even as to these ancillary facts there is little or no dispute. There is not a single finding of fact by the trial court, nor a single conclusion by the Circuit Court of Appeals which is based on conflicting testimony. The findings and conclusions of both tribunals are grounded altogether upon direct perception of the two marks and packages.

It is undisputed that petitioner's business done under its mark, including business in foreign countries, is the equivalent of 630,000,000 seven-ounce bottles of 7 *Up* annually; the business embraces the activity of 400 bottlers whose equipment and properties are independently owned and operated; the pattern of imitation adopted by respondents has been followed by other competitors who have reproduced *Up* in such combinations as *Hy Up*, *Lemon Up*, *Bubble Up*, and *Natural Set Up*.

Errors Relied Upon.

Upon allowance of the writ, petitioner will rely upon the following errors of the Circuit Court of Appeals:

1. The court erred in refusing to hold that *Cheer Up* is an infringement of petitioner's registered trade-mark *Seven Up* or 7 *Up*, under the Statute, 15 U. S. C. 96.

2. The court erred in refusing to hold that *Cheer Up* is an "interfering trade-mark" with *Seven Up* or 7 *Up*, under the Statute, 15 U. S. C. 102.

3. The court erred in refusing to hold that respondents' use of its bottle, exemplified by Plaintiff's Ex. 1, constitutes unfair competition with petitioner in respect to its bottle, exemplified by Plaintiff's Ex. 2, under the common law as interpreted by applicable decisions of Missouri courts.

ARGUMENT.

Summary.

I.

The question or questions presented involving deceptive similarity of marks is of sufficient importance to support the petition because—

(A) The decision is in conflict with a decision of the Court of Customs and Patent Appeals on the same subject matter, and with a course of decisions by that court.

(B) The particular facts here presented exemplify a broad pattern of imitation which, if sanctioned, deprives all two-word arbitrary marks of their exclusiveness in the trade.

(C) Trade-marks are private interests of an international character, and at this particular period of our national economy maintaining the legally ordained exclusiveness of American marks used in foreign countries is urgent, if not imperative.

(D) The case is of ultimate importance to petitioner in view of (a) the extensive sales and complete distribution in the United States of 7 Up and its developing trade in foreign countries; (b) the same expedient adopted by numerous other competitors who in tacit recognition of the ascendancy of petitioner's mark have joined in a concerted raid on its mark; and (c) the need for protection of over 400 bottlers whose businesses, independently owned and operated, are founded on the exclusiveness of petitioner's mark.

(E) In the wide demand for 7 Up the public is entitled to be protected from probable confusion and deception.

II.

The decision of the Circuit Court of Appeals is probably in conflict with an applicable decision of this court, *Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19, 33.

III.

The issue of unfair competition, involving common law, and therefore a question of local law, has been decided in a way in conflict with an applicable local decision, *McCann v. Anthony*, 21 Mo. App. 83.

I.

Federal Question.

The issues of trade-mark infringement and cancellation of registration involve an interpretation and application of the federal statutes, thereby presenting federal questions. And while the respective sections of the statutes use different words, it would seem to be clear that a single question is involved. If a registered trade-mark is an infringement of a senior registered mark used upon the same class of goods, obviously the two are "interfering registered trade-marks."

Whether the question is presented in abstract form or concrete form, and it is presented alternately both ways in the Petition, a federal question is presented and one which is of sufficient importance to support the Petition. A decision of the issue, even when present in its concrete form, involves only an application of the statutes in a comparison of the two trade-marks. In a patent case, where the issue is thus simplified, this court has held that a question only of law is involved. *United States v. Esnault-Pelterie*, 303 U. S. 26, 30. By analogy, it would seem that the same rule applies in a trade-mark case where

the comparison is even more direct and simplified, involving in the present case a comparison of only four words. But whether it is a question of law or a mixed question of law and fact, the decision of the Court of Appeals will form a precedent binding upon the district courts in the Eighth Circuit, and persuasive upon the federal courts in the other circuits, as well as in foreign countries.

(A) CONFLICT WITH COURT OF CUSTOMS AND PATENT APPEALS.

The importance of the question is demonstrated by a conflict with a decision of the Court of Customs and Patent Appeals on the same subject matter, and with a course of decision by that court.

That court, concurring with two Patent Office tribunals, in an opposition proceeding, held *Hy Up* to be deceptively similar to *Seven Up*, *Burstein v. Seven Up Co.*, 111 F. 2d 903. The Patent Office tribunals held *Lemon Up* to be deceptively similar to *Seven Up*, *The Seven Up Company v. Gerald G. Balch*, 511 O. G. 805. It cannot be maintained that there are any differentiating facts under the trademark laws in the three cases involving, respectively, *Cheer Up*, *Hy Up* and *Lemon Up*, as compared with *Seven Up*.

Nor were the decisions of the Patent Office and the Court of Customs and Patent Appeals in the *Hy Up* and *Lemon Up* cases merely isolated decisions in particular cases. They followed a course of decisions of the Court of Customs and Patent Appeals which has been established and followed without exception for a period of at least the last fifteen years. That course of decision is demonstrated by the following examples (in addition to *Burstein v. Seven Up Co.*, *supra*):

Jack Frost and Lemon Frost, In re Coca Cola Bottling Co. of Los Angeles, 49 F. 2d 838;

Celotex and Fir-Tex, Celotex Co. v. Millington, 49 F. 2d 1053;

Bon Ami and Shav-ami, Bon Ami Co. v. McKesson & Robbins, Inc., 93 F. 2d 915;

Four Roses and Maryland Rose, Frankfort Distilleries, Inc., v. Kaska Distillers Products Corp., 111 F. 2d 481;

Grape-Nuts and Wheato-Nuts, Langendorf United Bakeries, Inc., v. General Foods Corporation, 125 F. 2d 159.

These examples might be multiplied but those noted are exactly analogous to the marks in the present case. In each case the part reproduced was the terminal word or syllable. There are no facts which distinguish the present controversy from that group of cases. *Up*, as applied to a soft drink, is wholly arbitrary; it is neither descriptive nor suggestive of any characteristic of a soft drink or its ingredients. While, as respondents have sometimes contended, *Up* is a common word, it is arbitrary when applied to a soft drink and is no more a common word than *Frost*, *Rose* or *Nuts*.

It is true that decisions of the Court of Customs and Patent Appeals are not binding as judicial precedents and are not reviewable by this court (*Postum Cereal Co. v. California Fig Nut Co.*, 272 U. S. 693), but it is none the less true that the decisions of that court in matters pertaining to trade-mark cases are entitled to special consideration.

The Patent Office and the Court of Customs and Patent Appeals (not unlike the Land Office and Internal Revenue Department in their respective spheres) constitute a highly trained, specialized government agency exclusively charged with the duty of registering or denying registration of trade-marks used in interstate and foreign commerce.

Further, those tribunals have had the maximum experience in dealing with trade-marks. It is true of the Court

of Customs and Patent Appeals, as has been said of the Court of Appeals of the District of Columbia, which formerly exercised the same jurisdiction in trade-mark cases that it has "decided more trade-mark cases than all the other courts combined in the same length of time." *California Packing Corp. v. Tillman & Bendel, Inc.*, 40 F. 2d 108, 119.

Moreover, the Patent Office in the matter of trade-marks fulfills an international function obligated of the United States by Article 12 of the Convention of the Union for The Protection of Industrial Property. (See Appendix.)

We submit these convergent considerations bring the question involved within the frequently quoted language of this court in *United States v. Moore*, 95 U. S. 760, 763: "The construction given to a statute by those charged with the duty of executing it is always entitled to the most respectful consideration, and ought not to be overruled without cogent reasons."

(B) THE SITUATION PRESENTED IS WIDELY REPETITIOUS.

The use of a mark comprising two words is extensive. This is demonstrated by the large number of reported cases in which two-word marks have been involved.* It is also a matter of common knowledge and daily observation in the business world.

Respondents' action in seeking to cash in on the good will asset of petitioner by deliberately purloining one of the two arbitrary words which petitioner has fashioned into the symbol of such good will is a covetously inspired and frequently used artifice. This is attested by the seven variant analogous attempts frustrated by the Patent Office tribunals as above indicated.

*In the relatively few trade-mark cases decided by this court two-word marks are predominant, e. g. *Piper Heidsick*, *Hunyadi Janos*, *American Girl*, *Tea Rose*, *Old Crow*, *Round Oak*, *Coca-Cola*, *Poudre Java*, *Beech Nut*, *Nu Enamel*. Single-word marks embrace *Rex*, *Dauids*.

But the Circuit Court of Appeals, without noticing those decisions, has transformed the attempt from a failure into a success. The obvious import of the decision is that it is now permissible for late-coming competitors by a like manipulation to legally exact unearned tribute from any two-word mark, however arbitrary it may be.

Trade-mark windfalls that enable competitors to reap where they have not sown are quickly perceived and ubiquitously availed of.

We submit the obviously wide and unrestricted application of the decision to two-word marks generally renders this method of competition a proper and timely subject of inquiry by this court. It would be difficult to frame a trade-mark issue of wider reach or deeper thrust.

(C) IMPORTANCE OF THE QUESTION PRESENTED FROM THE
VIEWPOINT OF FOREIGN COMMERCE AND TRADE.

We respectfully request the court to consider the effect of the decision in the broad perspective of foreign commerce under trade-mark treaties between the United States and other nations.

In *Beckwith v. Commissioner of Patents*, 252 U. S. 538, 546, the court said the Trade Mark Act of the Congress is designed "to promote the domestic and foreign trade of our country."

A trade-mark is an important instrumentality of foreign commerce. The development and expansion of such commerce in a 5-cent consumable article, such as 7-Up, would be difficult, if not impossible, without the aid of a distinctive trade-mark identification, and by the use of its mark petitioner has projected its trade into Canada and Mexico, where by virtue of existing treaties its good will asset has enjoyed the protection of the laws of both nations. Such treaties constitute an integral part of the act of Congress authorizing the registration of trade-marks (U. S. C., Tit. 15, Sec. 81). This court has recently

ruled (*Bacardi Corporation v. Domenech*, 311 U. S. 150, 161, 164) that such a treaty is self-executing and confers a "substantive right" to the protection of the trade-mark. The treaties uniformly provide that a trade-mark shall have the same protection in the foreign country as it has in the country of origin. (In the Appendix we have reproduced relevant excerpts from the International Convention for the Protection of Industrial Property originally signed in Paris in 1883.) However, this court has held that such protection in the foreign country can be no greater than in the country of origin (*Saxlehner v. Eisner*, 179 U. S. 19, 35-6).

The trade-mark protection is approximately the same within the confines of the contracting nations.

In *Singer Manufacturing Company v. June Manufacturing Company*, 163 U. S. 169, in reaching its decision, the court dwelt at length upon the French and English law of trade-marks.

In *Kellogg Company v. National Biscuit Company*, 305 U. S. 111, 116, one of the grounds for granting the writ of certiorari was the decision of the British Privy Council passing upon the trade-mark involved.

Specifically, a two-word mark comprised of two arbitrary words has been held to be infringed by the reproduction of one of such words in conjunction with a word substituted for the other.

In Great Britain the mark *Silent Knight* applied to gas stoves is infringed by *Red Knight* applied to the same article. *Forth & Clyde & Sunnyside Iron Co. v. Sugg & Co.*, 45 R. P. C. 382.

In Canada, *Honey Dew*, as applied to an orange-flavored soft drink, is infringed by *Flora Dew* applied to the same beverage. *Honey Dew Limited v. Rudd* (1929), Exchequer Court of Canada 83.

We consider that this court has announced the same principle in the case of *Saxlehner v. Eisner*, *supra*, page

33, and the Court of Customs and Patent Appeals has consistently adhered to the rule in the instances cited above.

In the case at bar the Court of Appeals has set aside this principle with the result that all trade-marks of the type specified, originating in the United States, are greatly impaired, if not destroyed, for purposes of foreign commerce, while similar marks originating in other countries will be protected not only in the country of origin, but by force of the treaty will be protected here in the United States (*Rossman v. Garnier*, C. C. A. 8, 211 Fed. 401, 409).

As to all marks of the type in question, the decision (a) imports a ruinous discrimination between the scope and protection of marks originating in the United States in comparison with similar marks originating in other countries; (b) is equivalent to an involuntary disclaimer of the reproduced word—*Up* here; and (c) is an authoritative invitation to competitors in Canada, Mexico and other foreign countries to engage in the unfair competition reprobated by the explicit terms of the treaty.

The decision is the counterpart of what the court dealt with in *Bacardi Corporation v. Domenech*, *supra*. There the Legislature of Porto Rico attempted to shunt aside the reciprocal protection of the treaty. Here the Court of Appeals has not dealt with the treaty, but has destroyed the subject matter of the reciprocal protection.

Porto Rico attempted to discriminate in favor of its own citizens and against other nationals; the decision of the Court of Appeals imports a discrimination in favor of foreign traders and against citizens of the United States.

It is the fixed policy of the United States to encourage and promote foreign commerce by its citizens (U. S. C., Tit. 15, Sec. 197a). The decision of the Court of Appeals is calculated to discourage and to a measurable extent frustrate that international enterprise.

(D) IMPORTANCE TO PETITIONER.

The Seven Up Company, petitioner herein, has in a period of fifteen years by the excellence of its product, fair dealing, and a liberal expenditure for advertising, developed its business from a beginning to an annual volume of 630 million bottles, that is two million bottles per day. It is identified and known to the trade by its trade-mark. The importance to petitioner in keeping its trade-mark distinctive is best stated in the words of Mr. Justice Holmes in *A. Bourjois & Co., Inc., v. Katzel*, 260 U. S. 689, 692, as follows:

“It [monopoly of a trade-mark] deals with a delicate matter that may be of great value but that easily is destroyed, and therefore should be protected with corresponding care.”

The case is of further importance to petitioner because the same expedient employed by respondents is or has been used by a number of competitors. *Hy Up, Burstein v. Seven Up Co.* (C. C. P. A.), 111 F. 2d. 903; *Lemon Up, The Seven Up Co. v. Gerald G. Balch*, 511 O. G. 805.

Complaints brought by petitioner are pending against the purveyors respectively of competing goods under the names *Bubble Up* and *Natural Set Up* (R. 430, 431, 523, 524).

Respondents have produced a large number of registrations (Defts' Ex. 52, R. 452-464), subsequent to 7 Up, which employ UP as a part of the mark, presumably to compete with petitioner. A number of those marks so registered are used on bottles (Defts' Exs. 26 to 46), which the witness Cox, president of one of respondents, concedes are used for lithiated lemon or lithiated lemon lime sodas (R. 417), that is, on a product directly competing with 7 Up.

One competitor has the audacity to use as a part of his mark “King of the Up Drinks” (Reg. 362,879, R. 460).

This situation makes pertinent the remarks of the Court of Appeals of the District of Columbia in *Broderick v. L. Mitchell & Co.*, 289 F. 618. There the marks were *White Magic* and *Magic Marvel*, both applied to cleaning compounds. The court, in refusing registration of the junior mark, said:

“The word ‘Magic’ gives character to each. In the trade the goods of both parties, if the two marks were used, would soon be known as the Magic Compound or Cleaner.”

The present decision, if it does not open the door wide, then does give encouragement to these competitors and others to adopt numerous marks similar to 7 *Up* by reproducing petitioner’s “surname” *Up*. At the same time, other Competitors, as they have been doing (Defts’ Ex. 52, R. 457, 463), will adopt either the numeral or the word *Seven*, thus completely partitioning petitioner’s valuable mark.

It is not petitioner alone that is interested in this specific decision, but also over 400 bottlers, whose businesses are independently owned and operated, who compound and supply the drink locally to the public. Twelve of these bottlers (R. 343) have spent for advertising 7 *Up* a total of \$3,611,156.67. It may be explained that because of transportation costs and economic necessities the bottling of carbonated beverages is done locally, usually by concerns independently owned and operated, but who hold territorial grants with the national purveyor of the soft drink. *The Coca-Cola Bottling Co. v. The Coca Cola Co.* (D. Dela.), 269 F. 796.

(E) THE PUBLIC’S INTEREST.

The public in its desire or demand for 7 *Up*, extensive as it is, has a right to be protected from deception and confusion. One of the considerations for trade-mark protec-

tion is the interest of the public in the matter, even though it appears as a controversy between two private parties. The courts of the present day look to that protection of the public as much as the protection of private property in deciding issues of trade-mark infringement and unfair competition. The history of trade-mark laws emphasize this fact because in the beginning of this law in England the ground of the court's interference was merely to save the public from a fraud. Fox, *The Canadian Law of Trade-Marks and Industrial Designs*, p. 4.

In *Federal Trade Commission v. Good-Grape Co.* (C. C. A. 6), 45 F. 2d 70, 72, the court had under consideration the marking of a soft drink beverage to indicate artificial flavor and color. The following remarks of the court are just as pertinent to the present case as they were there:

"It is equally clear that a substantial public interest is involved. The beverage is sold for human consumption and ordinarily for immediate use, the labeled cap or crown having been first removed. The average purchaser makes for himself only a casual if any examination of the real character of this five-cent drink."

II.

Saxlehner v. Eisner & Mendelson Co., 179 U. S. 19.

Were it not for the refusal of the Circuit Court of Appeals to consider *Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19, which was urged both on the original presentation and in a petition for rehearing, we would assume the decision to be in direct conflict with that case. There the following principles were announced (l. c. 33):

"It is not necessary to constitute an infringement that every word of a trade-mark should be appropriated. It is sufficient that enough be taken to deceive the public in the purchase of a protected article. It

was said by Vice Chancellor Shadwell, in 1857, 'that if a thing contains twenty-five parts and but one is taken, an imitation of that one will be sufficient to contribute to a deception, and the law will hold those responsible who have contributed to the fraud.' *Guinness v. Ulmer*, 10 Law Times 127. While this may be a somewhat exaggerated statement, the reports are full of cases where bills have been sustained for the infringement of one of several words of a trade-mark."

The facts in the two cases are closely analogous and, where they are not parallel, the differences are not critical or decisive. The goods involved, mineral water in the one case and a soft drink beverage in the other, are similar. Both cases involve a two-word mark charged to be infringed by another two-word mark having one of the words common with the original. In the *Saxlehner* case the mark was *Hunyadi Janos* and the accused mark was *Hunyadi Matyas*.

Another point of similarity in the cases is that the part taken is "neither descriptive nor geographical, but merely arbitrary and fanciful as applied" to the goods (l. c. 30). *Hunyadi Janos* was the name of an Hungarian hero, and the mineral water was of Hungarian origin. *Seven Up* as a whole and as to each of its parts is likewise purely arbitrary and fanciful as applied to soft drinks.

In the *Saxlehner* case the common word formed the initial part of the mark, while here it is the terminal word, but it cannot be assumed that this distinguishes the cases. There is nothing in the reasoning of the court to suggest that a different result would have been reached if the marks had been reversed, *Janos Hunyadi* and *Matyas Hunyadi*.

In the one case the words are of foreign language origin, while here they are Anglo Saxon. But this cannot be a factor because the controlling element is their arbitrary

and fanciful nature in relation to the goods. Here again we may point out the international character of trade-marks. In Mexico and French-speaking Canada and other countries which use a language other than English, the *Up* in *Seven Up* and *Cheer Up* or other similar combinations of *Up* have the same foreign tinge as *Hunyadi*.

In the one case as in the other, the question persists: Is the reproduction of one of the two words calculated to distinguish or to confuse the two products?

III.

Unfair Competition, McCann v. Anthony, 21 Mo. App. 83.

The Circuit Court of Appeals has decided the issue of unfair competition, involving common law or local law, in conflict with an applicable decision of the Missouri courts, *McCann v. Anthony*, 21 Mo. App. 83.

The opinion of the Court of Appeals does not mention this Missouri decision, although petitioner called attention to it at the hearing and urged it specifically on petition for rehearing. According the full deference due the opinion and the inference from its failure to mention the Missouri decision, this ground for granting the writ is presented and urged with confidence and conviction.

The issue in the present case is illustrated in the Appendix by color photographs of petitioner's bottle and respondents' accused bottle. The physical exhibits themselves, respectively Plaintiff's Exhibits 2 and 1, are filed with this petition.

For convenience, the precedent decision relied upon is also printed in the Appendix. The labels involved in that case have been reproduced from the files of the court, as they actually appear in the original opinion.

The principle of law announced in that case is fully as applicable to the facts here as there and the facts in the two cases are parallel. Each point of similarity in the

packages pointed out by the court has its counterpart in the present case.

Furthermore, the question upon which each case turned is identical, but that question was decided by the Circuit Court of Appeals for the Eighth Circuit contrary to the applicable decision of the St. Louis Court of Appeals. That question may be framed as it is in the petition:

“In a comparison of the general appearance of two competing packages, each appearance being comprised of a complex combination of elements that taken severally are old, is it allowable to break up the combination by isolating and disregarding the presence of the background element of both combinations, because such element (not the combination) is in the public domain and thereupon to ground the absence of confusing similarity on the combination as so disrupted?”

In the *McCann* case this question is answered in the negative; in the present case it is answered in the affirmative.

In the *McCann* case the court pointed out that the entire combination of resemblances could be broken successfully by changing the color of the background, and said:

“The defendant can easily repair the wrong without much expense to himself and without destroying the plate upon which his label is printed, by adopting a color upon the background distinctly different from red, or by making a new plate and changing the other distinctive characteristics of form and size, above pointed out.”

In the present case the court (R. 552) eliminates the green glass background as an element in the combination, and then bases its judgment on the hypothetical structure remaining.

In the *McCann* case two witnesses for the plaintiff gave evidence they had been deceived by the defendant's label,

and the defendant introduced several witnesses who testified that they could not be deceived. But the court brushed aside this testimony and gave it no consideration, saying, l. c. 89, that the whole case must be decided upon a comparison of the two labels. In the present case (R. 552), however, the court apparently draws a presumption from the fact that no evidence of confusion, deception, or palming off, was offered.

In the *McCann* case the court held, l. c. 89, in relation to a decision on a comparison of the labels, "The sole question is, what conclusion of law is to be applied to the facts."

The court in discussing the principles of unfair competition said, l. c. 90, that the imitation is sufficient to call for the intervention of the court if "it be so close as to deceive the incautious and unwary."

The court found six points of resemblance between the labels, l. c. 91, and these points have exact counterparts in the present case, as will be seen from the following chart, comparing the facts here with the finding in that case:

THE MCCANN CASE.
(l. c. 91.)

THE PRESENT CASE.

- | | |
|---|--|
| "1. The general form. | 1. The same form and the same general arrangement. |
| 2. The oval vignette. | 2. The rectangular body panel. |
| 3. The lettering on the white field on the left hand side. | 3. The white lettering on the back. |
| 4. The lettering on the white field on the right hand side. | 4. The white neck label. |
| 5. The size. | 5. The size. |
| 6. The general color." | 6. The general color. |

In the present case not only is the background color the same, but there is a complex combination of other things: identity in shape and size; identity in means of decoration; similarity in arrangement; and correspondence in colors of decoration. (The difference between the two shades of red is not sufficient to make any impress upon the buying public. *Stuart v. F. G. Stewart Co.* [C. C. A. 7], 91 F. 243, 246. In advertising, neither party can nor does adhere strictly or closely to the exact hues, and the difference between the two is so slight that the color camera has difficulty in distinguishing them.)

In addition to the similarities in general appearance we find the identical location five times of the arbitrary *Up*; both petitioner and respondents use *Up* twice on the front and three times on the back of the bottle, each in the identical locations.

In the *McCann* case the defendant had placed upon its package the notation "Not Old Coon," but this was held to be insufficient to prevent confusion. In the present case the respondents have not only failed to take any measure to prevent confusion, but have added to the confusion and deception caused by the similarity in packages and similarity of marks by other means. They have used on the bottle the name of a straw corporation, "Cheer Up Sales Co. of St. Louis, Inc.," in simulation of the name of petitioner's bottler "Seven Up Bottling Co., St. Louis, Mo." In addition they have used on the bottle the expression "There is no substitute for Cheer Up," in simulation of petitioner's advertising phrase (Pltff's Exs. 27, 28, 29, R. 187-197) and to confuse the public into believing that it is the original.

The case of *McCann v. Anthony* is not one of first impression nor a pioneer case, but one decided by the court after having had several cases of this general nature before it, l. c. 89. It is intended to state and apply the settled

law in the state. The case was decided upon principles which were “well settled and understood” in that court.

It may be immaterial in this connection whether the rule in Missouri is anomalous or not, since that rule is the law in this case. But the rule is not anomalous. It was announced and followed by the Second Circuit in *N. K. Fairbank Co. v. R. W. Bell Mfg. Co.*, 77 F. 869, 876. There the court had before it two packages for soap powder. The court said:

“Color, undoubtedly, is a most important element in all package combinations; but there are other elements as well, which go to make up the entire combination. Because a total change of color would so change the general appearance as to destroy resemblance to another package, it by no means follows that color alone would be sufficient to produce a general appearance resembling another package. It would not be giving the complainant a monopoly of yellow to restrain the sale of a particular yellow package, where, in addition to the color, a number of other elements, each differing more or less from its analogue, in complainant’s package, had been so allocated together as to produce a general appearance calculated to delude the unwary purchaser.”

A widely followed decision on the question of unfair competition is an opinion by Mr. Justice Holmes, then on the Supreme Judicial Court of Massachusetts, *New England Awl & Needle Co. v. Marlboro Awl & Needle Co.*, 168 Mass. 154, 46 N. E. 386, 387. It was there said:

“Of course, a person cannot claim the monopoly of a color in connection with a particular line of trade, and very likely not in connection with the labels of a certain kind of goods generally; but the most universal element may be appropriated as the specific mark of a plaintiff’s goods if it is used and claimed only in connection with a sufficiently complex combination of other things. The plaintiff did not claim

the exclusive right to brown labels for awls, but it claimed the exclusive use of the brown color in the combination we have described. If the only other element besides the color had been a box of a certain size and a label of a certain shape, the case might be different (*Enoch Morgan's Sons Co. v. Troxell*, 89 N. Y. 292); but when there is added an inscription which, both in its pictorial aspect of black marks and in its meaning, was calculated to confuse, if not to deceive, the plaintiff's claim seems to us moderate."

That case was referred to by Mr. Justice Holmes in *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.*, 250 U. S. 28, 29, a case decided on its facts for defendant, but where it was said, as to the test for unfair competition:

"It is not necessary that the imitation of the plaintiff's feature taken alone should be sufficient to deceive. It is a fallacy to break the fagot stick by stick. It would be enough if taken with the elements common to the public the inscription accomplished a result that neither would alone."

It seems clear upon the application of the principles announced in *McCann v. Anthony* and a comparison of the facts in that case with the facts here, that the present decision is in conflict and untenable with the common law in Missouri, as announced and interpreted by an applicable local decision.

CONCLUSION.

Two questions are inherent in and in fact comprise the case; one relates to the scope and exclusiveness of two-word registered trade-marks, and the other relates to unfair competition in the use of confusingly similar packages. These questions can be stated abstractly in the terms of the principles involved, or concretely in the terms of the specific issues of the present action, and they have been stated in both forms alternately in the Petition.

The question relating to trade-marks, the infringement of *Seven Up* or *7 Up* by *Cheer Up*, stating the question concretely, and the concurrent registrability of the two marks, when applied to the same goods, involves the interpretation and application of the federal trade-mark statutes. It has been decided in a way probably in conflict with an applicable decision of this court in *Saxlehener v. Eisner*, *supra*, but because the Court of Appeals refused to consider the analogy between the cases, we are constrained to say the question has not been settled by this court. For the reasons appearing at length in the argument and abstracted in the summary, it is of such importance as to justify an allowance of the writ to the end that it may be settled by this court.

The other question, which relates to unfair competition, involves an application of common law and has been decided by the Court of Appeals in a way untenable with an applicable state decision.

Respectfully submitted,

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Counsel for Petitioner.



APPENDIX.

Trade-Mark Laws, Title 15, United States Code.

§ 96. Evidence of ownership; infringement, and damages therefor.

The registration of a trade-mark under the provisions of this subchapter shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs (Feb. 20, 1905, ch. 592, § 16, 33 Stat. 728).

§ 102. Suits involving interfering registered trade-marks.

Whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of

equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation (Feb. 20, 1905, ch. 592, § 22, 33 Stat. 729).

The Paris Convention of 1883 for the Protection of Industrial Property, Revised at Brussels 1900, at Washington 1911, at the Hague 1925, and at London 1934.

[The original and revised versions of the Convention are to be found in Malloy; *Treaties, Conventions Between United States and Other Powers* (1910, Vol. 2, pp. 1935, 1943, 1945; Vol. 3, p. 2953; Vol. 4, pp. 4945, 5516.

In Ladas; *International Protection of Trade Marks* (1929), p. 6, it is stated that the member countries of this Union are now thirty-eight, including the United States, Great Britain, Canada and Mexico. The excerpts printed below are copied from Derenberg; *Trade Mark Protection and Unfair Trading* (1936), pp. 1035-1050.]

ARTICLE 1.

1. The countries to which the present Convention applies constitute themselves into a Union for the protection of industrial property.

2. The scope of the protection of industrial property includes patents, utility models, industrial designs and models, trade-marks, commercial names and indications of origin or appellations of origin, as well as the repression of unfair competition.

* * * * *

ARTICLE 2.

1. Nationals of each of the countries of the Union shall, in all other countries of the Union, as regards the protection of industrial property, enjoy the advantages that

their respective laws now grant, or may hereafter grant, to their own nationals, without any prejudice to the rights specially provided for by the present Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights provided they observe the conditions and formalities imposed upon subjects or citizens.

* * * * *

ARTICLE 10. Bis

1. The countries of the Union are bound to assure to nationals of countries of the Union an effective protection against unfair competition.

2. Every act of competition contrary to honest practice in industrial or commercial matters constitutes an act of unfair competition.

3. The following particularly are to be forbidden:

(1) All acts whatsoever of a nature to create confusion by no matter what means with the establishment, the goods, or the services of the competitor.

(2) False allegations in the course of trade of a nature to discredit the establishment, the goods or the services of a competitor.

* * * * *

ARTICLE 12.

1. Each of the countries of the Union agrees to establish a special Government service for industrial property, and a central office for communication to the public of patents, utility models, industrial designs or models and trade marks.

2. This service shall publish an official periodical paper. It shall publish regularly:

(a) The names of the owners of the patents granted with a short designation of the patented inventions;

(b) Reproduction of the marks which have been registered.

**G. H. McCann et al., Appellant, v. G. W. Anthony,
Respondent.**

St. Louis Court of Appeals, February 23, 1886.
(21 Missouri Appeal Reports 83.)

Appealed from the Greene County Circuit Court, W. F.
Geiger, Judge.

Reversed and remanded with directions.

Bakewell & Bakewell, for the appellants.

Francis H. Shepard, for the respondent.

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THOMPSON, J., delivered the opinion of the court.

This is a suit in equity to enjoin a colorable imitation of a label, by which the plaintiffs have long marked an article of smoking tobacco of their manufacture, called "Old Coon Smoking Tobacco," which has acquired a valuable reputation in the market. This label is in form, size and color substantially as follows:

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The plaintiffs have used this label continuously since the year 1874, and have built up a large trade in this brand of tobacco. Their business has always been carried on at Springfield, Missouri. The defendant has also been engaged in manufacturing smoking tobacco at Springfield, Missouri, for several years past, and has for several years manufactured a brand of smoking tobacco, called "Old Bachelor Smoking Tobacco." In the year 1883, the plaintiffs began putting their "Old Coon Smoking Tobacco" in cloth bags, retaining the above label, which they had previously used on the paper bags, in which they had been accustomed to put up the same tobacco. Soon afterwards, namely, in the fall of 1883, the defendant began putting up his "Old Bachelor Smoking Tobacco" in cloth bags of the same size, at the same time changing his label, which previously had borne no colorable resemblance to the above label of the plaintiffs, to a label of the form, size, and color, substantially as follows, with the exception of the words "Not Old Coon":

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As soon as the plaintiffs discovered that the defendant was putting up his tobacco with this label, they took the advice of counsel, and, under their instructions, a letter was written by their attorney to the defendant on the twenty-ninth of December, 1883, notifying him that his label deceived the public. The defendant replied that if that was so he would make some change in his label so that the public would not be deceived; and accordingly he made a change by printing on his label in large black letters the words "Not Old Coon," as above shown. The defendant sent one of these labels to the plaintiffs' attorney, who replied that the change did not amount to anything, and afterwards commenced this action. Two witnesses for the plaintiffs gave evidence to the effect that they had been deceived by the defendant's label into a supposition that the tobacco was the plaintiff's tobacco known as "Old Coon." On the other hand, the defendant introduced several witnesses, residents of Springfield, who testified under objection, after being shown these two labels, that they could not be deceived into taking one for the other, and that, in

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their opinion, no one would be deceived into purchasing one for the other at a different time or place.

We do not think it necessary to rule upon the question of the propriety of admitting this last testimony because the counsel for both parties were so candid as to state on the argument, what seems very obvious to us, that the whole case must be decided upon a comparison of the two labels, there being no conflict in the testimony. We may, also, say, at this point, that, in our view, that portion of the argument, advanced in favor of the defendant which

presses upon our attention a consideration of the presumptions which obtain support of the judgment of the circuit court, and of the consideration to which the finding of that court is entitled, in a cause in equity, is entirely misapplied here. In a suit in equity where the facts are in dispute an appellate court will, according to the settled practice in this state, defer very considerably to the finding of the court below. Nor is it doubted that, where the question for decision is merely a question of law, the conclusions of the learned judges of the circuit court are entitled to respectful and considerate attention at the hands of the appellate courts; but, nevertheless, in such cases, the appellate courts are bound to give judgment according to their views of the law. Here, the facts being undisputed, the sole question is, what conclusion of law is to be applied to the facts; and, deferring very considerably to the opinion of the learned judge who decided this case, we nevertheless think that the plaintiffs are entitled to the substantial relief prayed for. We have had several cases of this general nature before us; the principles upon which they are to be determined are pretty well settled and understood; and there is no very serious difference as to those principles between the counsel of the opposing parties and the court. The governing principle is that one manufacturer shall not be allowed to impose his goods upon the public as the goods of another manufacturer and so derive a profit from the reputation of that other. It is not necessary

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that the trade-mark, trade-name, sign, label, or other device which is employed by one merchant for that purpose shall be an exact imitation or counterfeit of the trade-mark, trade-name, sign, label, or other device employed by the other manufacturer. Nor is it required that the imitation be so close as to

deceive cautious and prudent persons; it is sufficient that it be so close as to deceive the incautious and unwary, and thereby work substantial injury to the other manufacturer. Nor is it necessary to prove that actual fraud was intended by the manufacturer employing the simulated trade-mark, trade-name, sign, label, or other device, in order to entitle the other manufacturer to relief in equity or to an action for damages at law. Here, as in most other civil actions, the law does not attempt to penetrate the secret motives or intent with which the act is done, but contents itself with the conclusion that the party intended the natural and probable consequences of the act, and gives its judgment accordingly. These principles are embodied and discussed with more or less distinctness in the following cases: *Filley v. Fassett*, 44 Mo. 168; *Conrad v. Joseph Uhrig Brewing Co.*, 8 Mo. App. 277; *Gambel v. Stephenson*, 10 Mo. App. 581; *Sanders v. Jacobs*, 20 Mo. App. 96.

Applying these principles to the case before us, it is perceived that the defendant's label resembles the plaintiffs' in three distinct particulars, of form, size, and color.

1. In *form* it is an oblong, like that of the plaintiffs. It, also, has an oval vignette in the center, and the plaintiffs' has a circular vignette in the upper center. It, also, has the words, designating the number of the factory, printed in the left hand margin on a white field, the letters reading from the top downwards, as in the plaintiffs'. It, also, has the notice required by the internal revenue law, printed on a corresponding white field, on the right hand margin, the letters reading from the bottom upwards, as in the plaintiffs'.
- 2 In *size* it is the same as the plaintiffs'.
3. In *color* the whole

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background is red, the most conspicuous of the colors, as in the plaintiffs'. Leaving out of view the fact that the defendant began putting up his

tobacco in cloth bags soon after the plaintiffs began putting up their tobacco in the same kind of packages, which the defendant explains by stating that smoking tobacco could no longer be sold in paper packages, we find that there are no less than six distinct points of resemblance between the two labels. 1. The general form. 2. The oval vignette. 3. The lettering on the white field on the left hand side. 4. The lettering on the white field on the right hand side. 5. The size. 6. The general color. In view of these points of resemblance it is scarcely probable that when the defendant designed this label he did not have in his mind the distinct purpose of making as close an imitation of the plaintiffs' label as he felt it safe to do. Now, as he admits in his testimony that since he adopted this label his trade has increased, and does not state any facts which lead to the inference that this increase has been due to any other cause than his success in making this colorable imitation of the plaintiffs' label, we think it a fair conclusion that he had the purpose in view of banking, so to speak, on the plaintiffs' reputation and that he has measurably succeeded in so doing. We do not think that the printing of the words "Not Old Coon," upon the defendant's label affords a sufficient reparation of the wrong. The defendant can easily repair the wrong without much expense to himself and without destroying the plate upon which his label is printed, by adopting a color upon the background distinctly different from red, or by making a new plate and changing the other distinctive characteristics of form and size, above pointed out.

The judgment of the circuit court will be reversed and the cause remanded, with directions to enter a decree perpetually enjoining the defendant, his agents, and servants, from manufacturing, selling, or offering for sale, any smoking tobacco manufactured by him, or by any

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other than the plaintiffs, having affixed upon the packages or bags containing the same, the label described in the petition as used by the plaintiffs, or any other label having such characteristic features as to constitute a colorable resemblance of the plaintiffs' label. It is so ordered. All the judges concur.

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Chief - Supreme Court of S.

FILED

JUL 26 1945

CHARLES ELMORE DROPLEY
CLERK

IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1945.

No. 151.

THE SEVEN UP COMPANY,
Petitioner,

v.

CHEER UP SALES COMPANY OF ST. LOUIS, MISSOURI,
a Corporation, AMERICAN SODA WATER COMPANY,
a Corporation, and ORANGE SMILE SIRUP
COMPANY, a Corporation,
Respondents.

**RESPONDENTS' BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI.**

OLIVER T. REMMERS,
Counsel for Respondents.



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IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1945.

No. 151.

THE SEVEN UP COMPANY,
Petitioner,

v.

CHEER UP SALES COMPANY OF ST. LOUIS, MISSOURI,
a Corporation, AMERICAN SODA WATER COMPANY,
a Corporation, and ORANGE SMILE SIRUP
COMPANY, a Corporation,
Respondents.

**RESPONDENTS' BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI.**

WRIT SHOULD BE DENIED.

I.

1. No new or important question of federal law is involved. The point has been ruled on repeatedly by this Court and settled by the uniformity of the decisions.

Liggett & Myers Tobacco Co. v. Finzer, 128 U. S.
182;

Coates v. Merrick, 149 U. S. 562;

Standard Paint Co. v. Trinidad Asphalt Mfg. Co.,
220 U. S. 446;
Warner v. Lilly, 265 U. S. 526;
Joseph Schlitz Brewing Co. v. Houston Ice & Brew-
ing Co., 250 U. S. 28, 30;
Kellogg Co. v. National Biscuit Co., 305 U. S. 111,
121.

II.

Petitioner on this point relies on **Saxlehner v. Eisner & Mendelson**, 179 U. S. 19, 33. The only similarity between that case decided October 15, 1900, and this case is that both are suits over trade names, but the facts are widely dissimilar as is hereinafter noted at page 6.

III.

No local law is involved. The Federal decisions are in accord with the Missouri courts' rulings and vice versa. **McCann v. Anthony**, 21 Mo. App. 83, relied on by petitioner, was decided by the St. Louis Court of Appeals on February 23, 1886, and has no application here, not because of its age, but only because the trade name of the defendant there was not involved. Respondents are unable to find any Missouri decisions comforting petitioner. The Missouri cases supporting respondents' position are:

Ralston Purina v. Checker Food Products Co., 80 S. W. (2d) 717, St. Louis Court of Appeals;
National Bank in North Kansas City v. Bank of North Kansas City, 172 S. W. (2d) 967, Kansas City Court of Appeals;
Nicholson v. Stickney, 158 Mo. 158, Missouri Supreme Court.

ARGUMENT.

I.

An analysis of the various decisions relating to trade-marks and trade names establishes a definite and uniform line of reasoning. These criteria are:

1. Are the dominant characteristics of the trade names the same?
2. Do they look alike to the ordinary observer?
3. Do they have the same meaning or connotation?
4. Is the sound or pronunciation the same?
5. Is the design of the newcomer's mark substantially the same as that of the first user?

On unfair competition the courts have held:

1. The features common to the trade cannot be monopolized.
2. Neither color nor common package can be made exclusive.
3. While the combinations of common words in a phrase, not descriptive, may be protected, a common word used in the phrase cannot be monopolized, and the similarity or identity must exist in the dominant word.
4. While distinctive dress of goods cannot be imitated to perpetrate fraud or deception, the first comer cannot complain where he has adopted features of the dress common to the trade, or standard packages as to size, shape or color, unless the **name** or **mark**, itself, of the goods will probably deceive those who exercise **ordinary care** to discover the source of manufacture.

Respondents submit that upon the above analysis there is no infringement or unfair competition in Cheer Up and the District Court for the Eastern District of Missouri, Eastern Division, and the Eighth Circuit Court of Appeals have so held. These courts have held that the dominant characteristic of petitioner's label is the numeral "7" and "Cheer" the dominant word in respondents' trade name, notwithstanding petitioner's transparent claim that "up" is dominant. The two names have meanings and connotations not even remotely similar. Petitioner's trade name is copied from that of a card game. Respondents' trade name relates to a state of mind. The design of respondents' label is distinctly different from that of petitioner's. The pronunciation of one has no similarity to the other.

For the first time in all this litigation petitioner has adopted "up" as a "surname" (brief p. 16). However, upon petitioner's label the numeral "7" alone is many times the size of "up", so that word sinks into insignificance beside the numeral. Petitioner by the design of its label has made "7" the dominant and characteristic part of its label. Petitioner itself chose what part of its trade name should take dominion over the other and by that characterization petitioner is bound.

"The names and labels are unlike to the eyes, unlike to the ear, unlike in spelling, unlike in meaning and unlike in suggestion." Quotation from **Potter Drug & Chemical Co. v. Pasfield Soap Co.**, 102 F. 490, wherein it was held that "Cuticle Soap" did not infringe "Cuticura Soap."

The foregoing formula is followed in all or nearly all of the cases cited by petitioner. Petitioner cites **Frankfort Distilleries v. Kasko Distillers Products Corporation**, 111 F. (2d) 481 (p. 10 of brief), wherein the Court of Customs and Patent Appeals held that "Maryland Rose" was confusingly similar to "Four Roses" for whiskey. But in summarizing the two marks, the Court found that

“roses” was the dominant word and that the applicant had tendered disclaimer of the geographical term “Maryland.”

Then, too, in **Langendorf United Bakeries v. General Foods**, 125 F. (2d) 159, by the Court of Customs and Patent Appeals (p. 10 of petitioner's brief), that Court held that “Wheato-Nuts” as a name for a breakfast food cereal composed chiefly of wheat products was confusingly similar to the registered trade-mark “Grape Nuts” for the reason that “Wheato” was merely descriptive and the dominant part of the trade name was “Nuts.”

Petitioner relies upon **Burstein v. Seven-Up Company** (C. C. P. A.), 111 F. (2d) 903, but there the Court found the names had the same connotation. Here is what the Court said (l. c. 904):

“The brief on behalf of appellant points out that ‘Seven Up’ is the name of a well-known game played with cards. We assume that the court is expected to take judicial knowledge of this fact, as did the Examiner of Interferences. When this is done, we think we must also take cognizance of the fact that in playing the game the word ‘High’ (of which ‘Hy’ is a misspelling) is one of frequent use. So, when the per se meaning of the respective terms (we agree they are arbitrary as applied to the goods) is considered, there is, it appears to us, a suggestiveness of similarity. Appellee's marks designate a game and appellant's syllable ‘Hy’ a point in that game.”

As to **The Seven-Up Co. v. Gerald G. Balsh**, 511 O. G. 805, cited by petitioner (pp. 9, 15 of brief), involving “Lemon Up,” it is easily recognized that “Lemon” is descriptive of the product and therefore is not registerable, leaving only the word “up.”

The petitioner (p. 10 of its brief) admits that “It is true that decisions of the Court of Customs and Patent

Appeals are not binding as judicial precedents and are not reviewable by this Court," nevertheless cites as authority cases by that court and asserts conflict with this decision of the Eighth Circuit. However, there is no conflict as late as October 2, 1944, for that Court in the case of *Miles Laboratories, Inc., v. Foley & Co.*, 144 F. (2d) 888, held that the trademarks "Vitamiles" and "Vitabuild" as applied to vitamin pills are distinctive in character and confusion is not likely to result from their concurrent use; that neither party could successfully contend that it is entitled to preempt the field to "vita."

II.

The only similarity between the **Saxlehner v. Eisner & Mendelson Company** (Hunyadi case), 179 U. S. 19, 33, decided October 15, 1900, and this case is that both are suits over trade names. There the similarity comes to an abrupt conclusion. The facts in the Hunyadi case as revealed in the decision are that while the full name of the Hungarian mineral water, plaintiff's product, was Hunyadi Janos, it was known throughout the United States and England as "Hunyadi" (l. c. 20, 21). This water was put up in "novel style of bottles and a peculiar label." The defendant also bottled Hungarian waters and called them "Hunyadi Lazlo" and "Hunyadi Matzas" and was selling this water "in bottles of the same size and shape as the plaintiff's containing a label in three parallel panels of the same colors, size and general design as those of the plaintiff" (l. c. 30). Therefore defendant counterfeited plaintiff's novel style of bottle and peculiar label. Mr. Justice Brown observed (l. c. 31):

"Practically the only defenses pressed upon our attention are those of abandonment and laches."

Not even a remote parallel can be drawn between the Hunyadi case and this case.

The bottles used by 7 up are of stock style known as "water bottles" and were freely used in the soft drink trade for 25 years before 7 up started in business (R. 369, R. 434, R. 439, R. 473). The 7 up label and that of Cheer Up are dissimilar in size, shape, design and color.

III.

McCann v. Anthony, 21 Mo. App. 83, is relied on by petitioner. That case was decided by the St. Louis Court of Appeals on February 23, 1886. The trade name of the defendant was not involved. The sole question decided by the St. Louis Court of Appeals was similarity of label and with that decision respondents find no fault. From the report of that case we find (l. c. 87, and p. 31 petitioner's brief) that:

"* * * In the year 1883, the plaintiffs began putting their 'Old Coon Smoking Tobacco' in cloth bags, retaining the above label, which they had previously used on the paper bags, in which they had been accustomed to put up the same tobacco. Soon afterwards, namely, in the fall of 1883, the defendant began putting up his 'Old Bachelor Smoking Tobacco' in cloth bags of the same size, at the same time changing his label, which previously had borne no colorable resemblance to the above label of the plaintiffs, to a label of the form, size, and color, substantially as follows, with the exception of the words 'Not Old Coon':

(label)

"As soon as the plaintiffs discovered that the defendant was putting up his tobacco with this label, they took the advice of counsel, and, under their instructions, a letter was written by their attorney to the defendant on the twenty-ninth of December, 1883, notifying him that his label deceived the public. The defendant replied that if that was so he would make some change in his label so that the public would not

be deceived; and accordingly he made a change by printing on his label in large black letters the words 'Not Old Coon,' as above shown."

Missouri Cases in Harmony With 8th Circuit's Decision.

In **Ralston Purina v. Checker Food Products Company**, 80 S. W. (2d) 717, the St. Louis Circuit Court dismissed plaintiff's bill and, on appeal to the St. Louis Court of Appeals, this was affirmed. Plaintiff had registered its trademark "Checkerboard" for its various food products. Defendant manufactured and sold a product similar to one of plaintiff's. Plaintiff's "Checkerboard" was red and white; defendant's a dull green. The Court denied injunction enjoining the use of "checker" in defendant's corporate name and to designate its food products, saying, l. c. 720:

"And it seems almost inconceivable to us, as we view the numerous exhibits in the case, that anyone would be beguiled by defendant's marking into the purchase of one of its products believing that it belonged to plaintiff's checkerboard line. In fact, we are led from the whole record to believe that the public has been trained and induced to seek out and call for plaintiff's products by their particular identifying names, rather than as checkerboard products, and that any chance of confusion by reason of defendant's present marking of the goods and its use of the trade-name 'Checker' is remote indeed."

The Kansas City Court of Appeals in **The National Bank in North Kansas City v. Bank of North Kansas City**, 172 S. W. (2d) 967, l. c. 969, stated:

"It seems clear to us that the name The National Bank in North Kansas City is quite different from the corporate name Bank of North Kansas City. The dominant feature of plaintiff's title is 'The National.' The public generally recognizes and understands

many of the differences in a national bank and a state bank, and we can see no justifiable basis for the contention that the names are so similar that persons and institutions in the use of reasonable care are likely to be deceived thereby."

The Missouri Supreme Court in **Nicholson v. Stickney**, 158 Mo. 158, held there was no infringement in the use of the picture of the St. Louis Union Station on cigar boxes where one was labeled "Union Station, St. Louis" and the other "Gilpin, Union Station."

Comment on Petitioner's Citations and Observations.

In the case of **In re Coca-Cola Bottling Company of Los Angeles**, 49 F. (2d) 838, cited by petitioner (Brief p. 9), the Court of Customs and Patent Appeals clearly followed the rule in finding that "Lemon Frost" infringed upon "Jack Frost" for the very obvious reason that "Lemon" was descriptive and alone would not be registerable and in common parlance "Frost" and "Jack Frost" are frequently used interchangeably.

Respondents emphatically dispute petitioner's statement (p. 5 of its brief) that "there is not a single finding of fact by the trial court, nor a single conclusion by the Circuit Court of Appeals which is based on conflicting testimony." H. C. Grigg, president of the complainant corporation, stated that in 1929 his company was the first to use lemon-lime with sodium and lithium (R. 98-99, 102) and that it was an original drink, dissimilar to any other drink in combination of elements. However, Defendants' Exhibit 9 (R. 505), being the issue of the National Bottler's Magazine of May 15, 1929, contained the illustrated advertisement of "Virginia Dare" lime and lithia in the green bottle and labeled and published in the same issue (Def. Ex. 9a) (R. 506) was an advertisement of "7 up" saying it was made of seven aromatics, blended with

carmel color. Grigg (R. 111) said his company had designed the crown. Later he admitted the standard crown for beer and soda bottles had been in use for many years prior to the establishment of his company. What he meant was his company designed the printing on the crown. He stated (R. 135) that in 1932 his company advertised that the bottlers of "7 up" must use a seven ounce flint (R. 131) green or brown bottle. Second-hand bottles were recommended (R. 270) and that green bottles were in use by others before used by plaintiff (R. 272-273).

Grigg testified that his father had coined the word "lithiated" (R. 161), and that it had never been used before; that it was original with his company. Defendants proved with their Exhibits 2, 3 and 4 (R. 47-487) that the Pure Food Regulations of 1908 required the use of the word "lithiated" when lithium salts were added, and in Fenner's Twentieth Century Formulary published in 1904 was found the word "lithiated," and the book "Beverages and Their Adulterations," by Dr. Harvey W. Wiley, wherein Dr. Wiley referred to the food and drug regulation requiring the use of the word "lithiated."

Petitioner, during the trial and on appeal, asserted and reasserted that it was the first to use the green bottle with labels for lemon-lime soda (R. 5), was the first to use two color applied color labels, all of which was contradicted by the testimony offered by respondents. The trial court resolved those controverted issues in favor of defendants and the Circuit Court of Appeals affirmed.

Petitioner asserted and reasserted in its brief before the trial court and before the Eighth Circuit that respondents copied plaintiff's package, that is, green glass, when petitioner and all of the trade knew that green glass bottles for soda water were in common use for many years prior to the advent of 7 up (R. 434, R. 439, 471, R. 473). The same claim was made as to the particular shape of the bottle when that shape was known to the trade for decades as a "water bottle."

IV.

No Question of Foreign Trade or Treaties Involved.

Petitioner spends considerable space (Brief, pp. 12, 13, 14) on "(C) importance of the question presented from the viewpoint of foreign commerce and trade." What that question has to do with the issues presented here respondent is unable to comprehend. Petitioner cites **Bacardi Corporation v. Manuel I. Domenech**, 311 U. S. 150. Mr. Chief Justice Hughes, speaking for the Court and interpreting the General Inter-American Convention for Trademark and Commercial Protection signed at Washington on February 20, 1929, stated that, among the many purposes of the convention, l. c. 159:

"It is further provided that labels, industrial designs and slogans used to identify or to advertise goods shall receive the same protection accorded to trademarks in countries where they are considered as such, upon compliance with the requirements of the domestic trademark law (Art. 5). The owner of a mark protected in one of the contracting states is permitted to oppose registration or deposit of an interfering mark (Art. 7); * * *."

And again Mr. Chief Justice Hughes, l. c. 163, found that the convention provided that:

"If duly registered or legally protected in one of the contracting states, the mark is to be admitted to registration or deposit and is to be legally protected in the other contracting states. The condition of that protection in the other states is compliance 'with the formal provisions' of the domestic law. This clearly indicates that formalities or procedural requisites are envisaged and that when these have been met it is the intent of the treaty to confer a substantive right to the protection of the foreign mark."

It is therefore clear that the trademark rulings of the courts of the home nation of the product will be recognized in the other nation's signatories to the convention. What petitioner is complaining of is that under the convention Canada and Mexico will follow the decision of the Eighth Circuit [148 F. (2d) 909] in this case. That is as it should be. The very purpose of the convention was to establish uniformity in patents and trademarks throughout the North and South American countries.

V.

Petition Does Not Comply With Rule.

This case does not come within the purpose of Rule 38, 5 (b) of this Court, for the decision of the Circuit Court of Appeals, Eighth Circuit (148 F. [2d] 909), is not in conflict with the decision of another Circuit Court of Appeals on the same matter, but, to the contrary, the Eighth Circuit's decision is in harmony with other decisions on the same subject. No question of local law is involved, for the Eighth Circuit's decision is consonant with Missouri decisions on the same or similar subjects. The Circuit Court of Appeals' decision is not untenable or in conflict with the weight of authority. The decision of the Circuit Court of Appeals is in accord with the decisions of this Court on a subject upon which this Court has on several occasions spoken. The Eighth Circuit has not departed from the accepted and usual course of judicial proceedings.

The Circuit Court of Appeals' decision follows what has been recognized as the established law on trademark registration. Petitioner's reasons (p. 4 of its brief) relied on for granting of writ are frivolous.

No important question of federal law is involved. This Court has repeatedly expressed its views on the topic. The case of **Joseph Schlitz Brewing Company v. Houston**

Ice & Brewing Company, 250 U. S. 28, is persuasive here. The Schlitz Brewing Company was one of the first breweries, if not the first, to use amber or brown bottles for beer. Houston Ice & Brewing Company later adopted a brown bottle for its beer, and also had a brown label substantially the same color as Schlitz's brown label. The Circuit Court of Appeals, Fifth Circuit, said that though purchasers of bottled beer might be deceived as to its maker by the color of the bottle or such color in connection with the color of the label, but where all breweries had a right to adopt and use bottles and labels of that color, the resemblance in color between plaintiff's and defendant's bottle beer and label afforded no ground for relief, as the resemblance justifying relief must be in matters which the complaining party has the right to use exclusively. Mr. Justice Holmes, in writing for this Court, and in affirming the Circuit Court of Appeals, said (l. c. 29):

“This is a bill in equity, brought to restrain the use of a trademark alleged to infringe the plaintiff's, or at least to be used in a way that is calculated to deceive and unfairly to interfere with the plaintiff's good will. Both courts have found for the defendant (154 C. C. A. 519, 241 Fed. 817), so that the only question that we shall consider is whether, upon inspection, it can be said as matter of law that the admitted acts of the defendant are a wrong of which the plaintiff can complain.

“Both parties sell beer in brown bottles, with brown labels, and the plaintiff conceded below and still with some unwillingness seems to concede that, although perhaps it first introduced them in this connection and this place, it cannot claim the brown bottle, the brown label, or the two combined. These could be used without a warning, such as sometimes is required, that the beer was not the plaintiff's. The only question is how the additional element,

the form of the inscription, should be treated. It often is said that the plaintiff must show a deception arising from some feature of its own not common to the public."

It is noted that petitioner, not only before the District Court and the Circuit Court of Appeals, but also here, lifts a literary obiter dictum from the Schlitz opinion (brief, p. 24) in support of its position, unmindful that this Court, on a similar state of facts, held against petitioner's position.

VI.

The present case was exhaustively presented during six days of trial before the District Court. Both sides presented printed briefs to the trial court and in due time thereafter the Court filed its findings of fact and conclusions of law dismissing plaintiff's bill. The District Court not only had physical exhibits but, in addition, defendant submitted colored photographs in its brief. The trial court's findings of fact are found on pages 535 and 536 of the record.

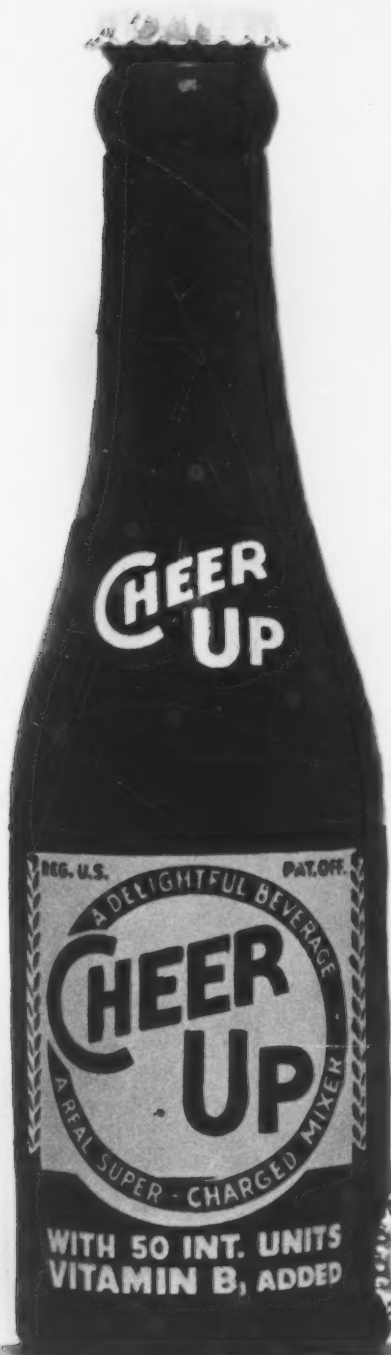
The Eighth Circuit Court of Appeals affirming likewise had the physical exhibits before it as well as colored photographs in defendant's brief. The matter was submitted after complete argument wherein the subject apparently was exhausted. That Court (R. 551) said: **"When we compare the appearance of the marks we see no deceptive similarity, and the pronunciation is unlike. We are impressed the contrast is more striking than the similarity."**

The Circuit Court of Appeals also found (R. 552):

"Here there is no evidence of confusion, deception or palming off, notwithstanding the plaintiff and defendants dwell in the same city and have been mar-







**CHEER
UP**

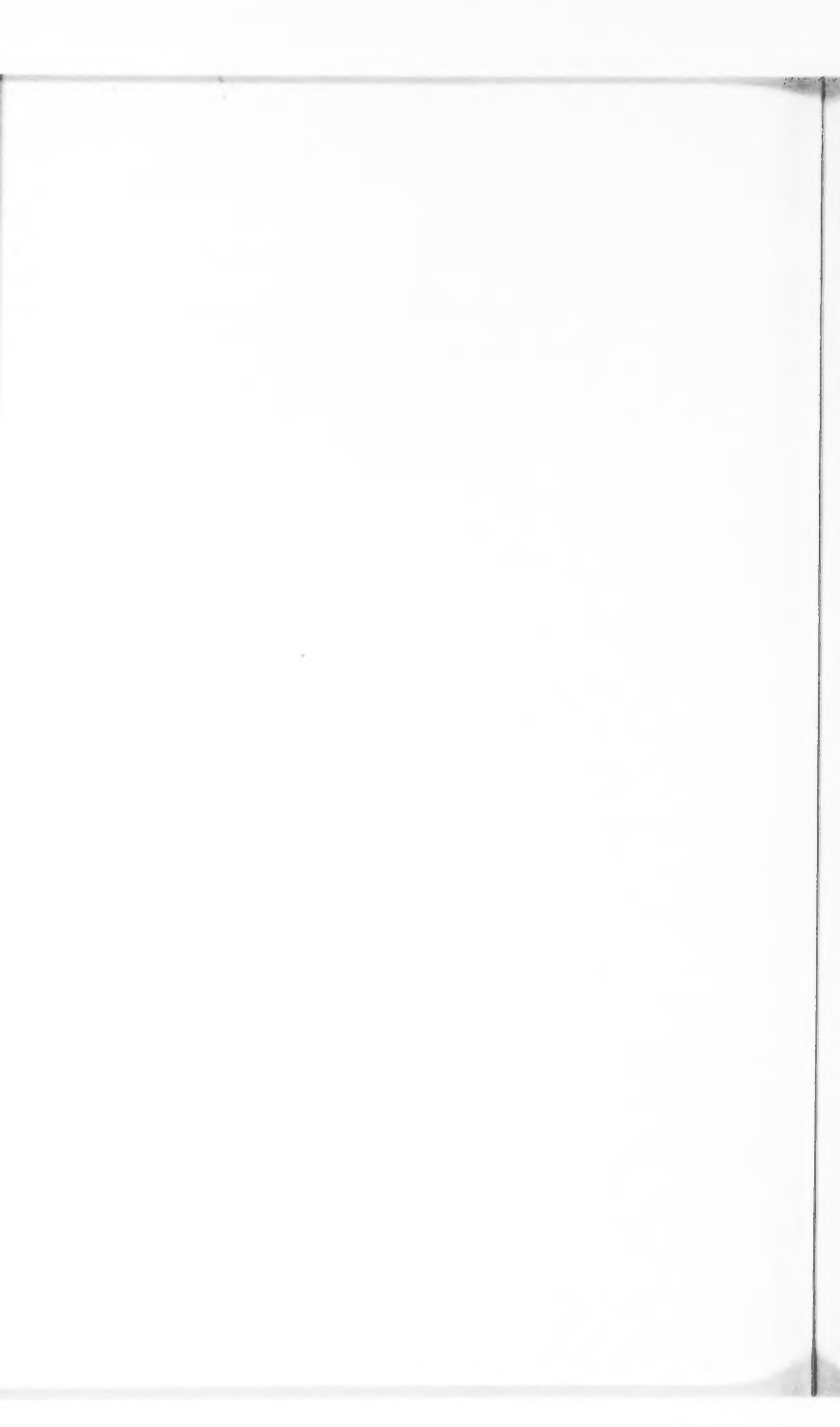
REG. U.S.

PAT. OFF.

**CHEER
UP**

WITH 50 INT. UNITS
VITAMIN B, ADDED

**CHEER
UP**



keting their goods in the same territory for many years and in the same 'dress' for the past seven years. During this period neither of them has made any substantial change in the type of bottles used or in the labels applied to them. During this period plaintiff never complained or gave notice of alleged infringement or of unfair competition. The question of deception and of palming off, therefore, is one of probability only."

The C. C. A. opinion in full is found on pages 545 to 553 of the record.

In **Miles Laboratories, Inc., v. United Drug Co.**, 112 F. (2d) 814, the Court of Customs and Patent Appeals, at l. c. 817, was of the opinion that the dominant portion of "Alka Seltzer" is the term "Alka," and that the dominant portion of "Rex Seltzer" was the term "Rex," and that the appellant was not entitled to the exclusive use of the word "Seltzer." Found that the term "Rex" in appellee's mark is sufficiently dissimilar from the term "Alka" in appellant's mark so that, when considered in their entireties, the marks are not confusingly similar.

A somewhat similar case (and there are many others of like import) is **Switzer v. Collins**, Court of Appeal, D. C., 23 F. (2d) 775, involving the trade names "Honeymels" and "Buttermels," where the Court said:

"The suffix 'mels' being common to both marks, the distinctive feature is between the words 'honey' and 'butter.'"

Apt is the language of the Court of Appeals for the 7th Circuit in the case of **S. R. Feil Co. v. John E. Robbins Co.**, 220 F. 650. There complainant used the term "Sal-Vet" and the defendant used the term "Sal-Tone," both on similar products. The Court (l. c. 652) stated:

“In the present case defendant has appropriated only the term ‘Sal,’ which he and everyone else was at liberty to use. As between the arbitrary term ‘Vet’ and the word ‘Tone,’ there can be no reasonable claim to resemblance. No ordinary purchaser would take the one for the other, even in combination with the word ‘Sal.’ One is not required to so distinguish his goods that careless buyers will know by whom they are made and sold.”

Resume of Trade Names Not Infringed.

The following summary gives names and citation of cases wherein the Courts, in cases in point, found no infringement. Cases where certiorari was denied are also noted.

Pepsi-Cola and Coca-Cola,

2 D. L. R. 657 (Canada);

Royal Crown Cola and R. C. Cola and Coca-Cola,

New Jersey Court of Chancery;

“Our Country” and “Old Country,”

Wrisley Co. v. Iowa Soap Co., C. C. A., 8th Cir.,
122 F. 796;

“Kickernick” and “Kickaway” in children’s overalls,

Winget Kickernick Co. v. LaMode Garment Co.,
42 F. (2d) 513;

Same-Kresge v. Winget, C. C. A., 8th Cir., 96 F.
(2d) 978;

Rubberoid and Rubbero,

Standard Paint Co. v. Trinidad Asphalt Mfg. Co.,
220 U. S. 446, 31 S. Ct. 456;

Dixi-Cola and Coca-Cola,

Dixi-Cola Laboratories v. The Coca-Cola Co., 117
F. (2d) 352, C. C. A., 4th Cir., **cert. denied**, 62
S. Ct. 60;

Barunduck and Burundell’s,

Sidney Blumenthal v. Salt’s Textile Mfg. Co., 21
F. (2d) 470;

- Dysco and Selco,
Davies-Young Soap Co. v. Selig Co., 16 F. (2d)
352, Ct. of Ap. D. C.;
- Union World and Union Leader,
American Tobacco Co. v. Globe Tobacco Co., 193
F. 1015;
- Zonite and Zonox,
18 T. M. R. 59;
- Palm Beach and Palm Knit,
Goodall Worsted Co. v. Palm Knitting Co., 10 F.
(2d) 1013; Ct. of Ap. D. C.;
- Liebro and Helbro,
19 T. M. R. 382;
- Blue Ribbon and Blue Anchor,
Premier Malt Products Co. v. Kasser, 23 F. (2d)
98, 26 F. (2d) 1021; C. C. A., 3rd Cir.;
- Valvoline and Havoline,
Valvoline Oil Co. v. Havoline Oil Co., 211 F. 189;
- Fashionknit and Fashion Club, or Fashion Park,
Franklin Knitting Mills v. Kassman & Kessner, 13
F. (2d) 319; Ct. of Ap. D. C.;
- College Comics and College Humor,
Collegiate World Pub. Co. v. Du Pont Publ. Co.,
14 F. (2d) 158, 25 F. (2d) 1018, C. C. A. 7th;
- Quin-Coco and Quin-Quinine,
Warner v. Lilly, 265 U. S. 526;
- Hot Shot and Hot Patches,
Shaler Co. v. Rite-Way Products Co., 107 F. (2d)
82, 6th Cir., **cert. denied**, 310 U. S. 634;
- Syneromatic and Air-O-Matic,
Syneromatic Conditioning Corp. v. Williams Oil-
o-Matic Heating Corp., 109 F. (2d) 784, C. C.
P. A.;
- Turnlox and Speedlox,
Benjamin Electric Co. v. Bright Light Reflector
Co., 29 F. Sup. 790, aff. 111 F. (2d) 880, C. C.
A. 7th;

- Cream Wipt and Miracle Whip,
Kraft-Phenix Cheese Corp. v. Levin, 29 F. Sup.
813;
- Steem Electric and Steam-O-Matic,
Steem Electric Corp. v. Herzfeld-Phillipson Co.,
29 F. Sup. 1011;
- Resistal and Resista,
Corning Glass Works v. Pasmantier, 30 F. Sup.
477;
- Municipal Street Sign Co., Inc., v. City Street Sign
Corp., 30 F. Sup. 795;
- Sun-ees and Cool-ees,
Joyce, Inc., v. Fern Shoe Co., 32 F. Sup. 401;
- Rotabin and Ro-Tray,
Frick-Gallagher Mfg. Co. v. Rotray Corp., 33 F.
Sup. 727;
- Star Plug Tobacco and Starlight Plug Tobacco,
Liggett & Myers Tob. Co. v. Finzer, 128 U. S. 182;
- Coates "Best Six Cord" and Merrick "Best Six
Cord,"
Coates v. Merrick, 149 U. S. 562, 13 S. Ct. 966;
- No-To-Bac and Baco-Curo,
Sterling Remedy v. Eureka Chemical, 80 F. 105,
C. C. A. 7th;
- American Lady and American Girl, if name of maker
is shown,
Hamilton-Brown v. Wolf Bros., 240 U. S. 251;
- Vapex and Vapo-Rub,
Vick Chemical Co. v. Thomas Kerfoot & Co., 80
F. (2d) 73, C. C. P. A.;
- "H. M." and "M. M.,"
McDonald & Morrison Mfg. Co. v. H. Mueller Mfg.
Co., 183 F. 972, C. C. A. 8th;
- Picture of St. Louis Union Station on cigar boxes, one
labeled "Union Station, St. Louis," and the other
"Gilpin, Union Station,"
Nicholson v. Stickney, 158 Mo. 158;

Solventol and Solvite,

Solventol Chemical Products Co. v. Langfield, 134
F. (2d) 899, C. C. A. 6th;

Kurlash and Starlash,

Younghusband v. Kurlash Co., 94 F. (2d) 230,
C. C. P. A.;

Houston Post-Dispatch and St. Louis Post-Dispatch,
Pulitzer Publishing Co. v. Houston Printing Co.,
11 F. (2d) 834, C. C. A. 5th., **cert. denied**, 273
U. S. 694;

Opalite and Oplex,

Flexlume Sign Co. v. Opalite Sign Co., 292 F. 98,
C. C. A. 7th., **cert. denied**, 263 U. S. 718;

Cuticle Soap and Cuticura Soap,

Potter Drug & Chemical Co. v. Pasfield Soap Co.,
102 F. 490;

Roof Leak and Never Leak,

Sears, Roebuck v. Elliott Varnish Co., 232 F. 588,
C. C. A. 7th, **cert. denied**, 242 U. S. 635;

Bouquet des Amours and Fleurs D'Amour not in-
fringed by Charme D'Amour or Caresse D'Amour,
Parfumerie Roger & Gallet v. M. C. M. Co., 24 F.
(2d) 698, C. C. A. 2nd;

Roxa Kola and Coca-Cola,

Coca-Cola Co. v. Carlisle Bottling Co., 43 F. (2d)
101, 43 F. (2d) 119, C. C. A. 6th, **cert. denied**,
282 U. S. 882;

Krank's Lather Kreem and Twilight Lather Cream,
Frank v. Pabst, 277 F. 15, C. C. A. 6th;

Narcisse Noir and Narcisse Juane,

Caron v. Vivaudou, 4 F. (2d) 995, C. C. A. 2nd;

Blue Whirl and Blue Streak not infringed by Blue Tip,
Turner & Seymour v. A. & J. Mfg. Co., 20 F. (2d)
298, C. C. A. 2nd;

Sal-vet and Sal Tone,

Feil v. Robbins, 224 F. 650, C. C. A. 7th;

Spearmint not infringed by Peptomint,
Larson v. Wrigley, 253 F. 914, C. C. A. 7th, **cert.
denied**, 248 U. S. 580;

Dysco not infringed by Selco,
Davies-Young v. Selig, 16 F. (2d) 352, Ct. of Ap.
D. C.;

Buttermels not infringed by Honeymels,
Switzer v. Collins, 23 F. (2d) 775, Ct. of Ap. D. C.;

Speedex not infringed by Speedway,
AnSCO Photoproducts v. Eastman Kodak, 19 F.
(2d) 720, Ct. of Ap. D. C.;

Everlasting not infringed by Evertight,
Everlasting Valve Co. v. Schiller, 21 F. (2d) 641;

Blony a name for bubble gum not infringed by Bubly
for same product,
Gum, Inc., v. Gumakers of America, 136 F. (2d)
957, C. C. A. 3rd;

Pyrex not imitation of Rex,
Walgreen v. Obear-Nester, 113 F. (2d) 956, 8th
C. C. A., **cert. denied**, 311 U. S. 708;

As to packages common to the trade,
P. Lorillard Co. v. Peper, 86 F. 956, C. C. A. 8th,
cert. denied, 171 U. S. 690; Joe Schlitz Brew-
ing Co. v. Houston Ice & Brewing Co., 250
U. S. 28.

Registrations of "7" and "Up" Prior to Petitioner's Registration.

The numeral "7" and the word "up" were used by others before plaintiff registered. "Seven Up" was registered as a trade-mark for citrus fruit on February 1, 1916. Combinations using "7" and "up" have been numerous prior to plaintiff's January 7, 1936, registration (Deft's X. 52, R. pp. 452-464):

For Jack Daniels whiskies "Old No. 7," May 24, 1904;
"Pik-Me-Up" for a non-alcoholic beverage, May 28,
1907;

"Seven-Eleven" and "7-11" for certain medicine,
August 13, 1907;

"Bubble-Up" for a non-fermented, non-alcoholic soft
drink, April 12, 1921;

For playing cards "7-11," February 14, 1922;

"7-11" for candies, July 24, 1943;

"7 Fruits" for food flavoring extracts, July 31, 1923;

"Six Up" for candies, November 27, 1923;

"Two-Up" for golf balls, February 19, 1924;

"Seven-Eleven" for hosiery, November 17, 1925;

"One-Up" for tobacco cases or pouches, Feb. 9, 1926;

"7-11" for wheat flour, February 23, 1926;

"7-11" for candies, August 16, 1927;

"Lucky 7" for floor mops, September 6, 1927;

"Pick-Me-Up" for a non-alcoholic, non-cereal soft
drink, November 20, 1928;

"7 Fruits" for non-alcoholic, non-cereal soft drinks,
January 8, 1929;

"7-11" for fresh grapes, January 8, 1929.

Plaintiff in 1943 purchased from Anheuser-Busch the
trade-mark "Pickmeup" registered in the Patent Office by
Lysander D. Childs in May, 1907 (R. p. 516). "Bubble-
Up" was registered in the Patent Office in 1919. Both are
names for soft drinks and both trade names with "up"
in them antedated 7 up by many years.

CONCLUSION.

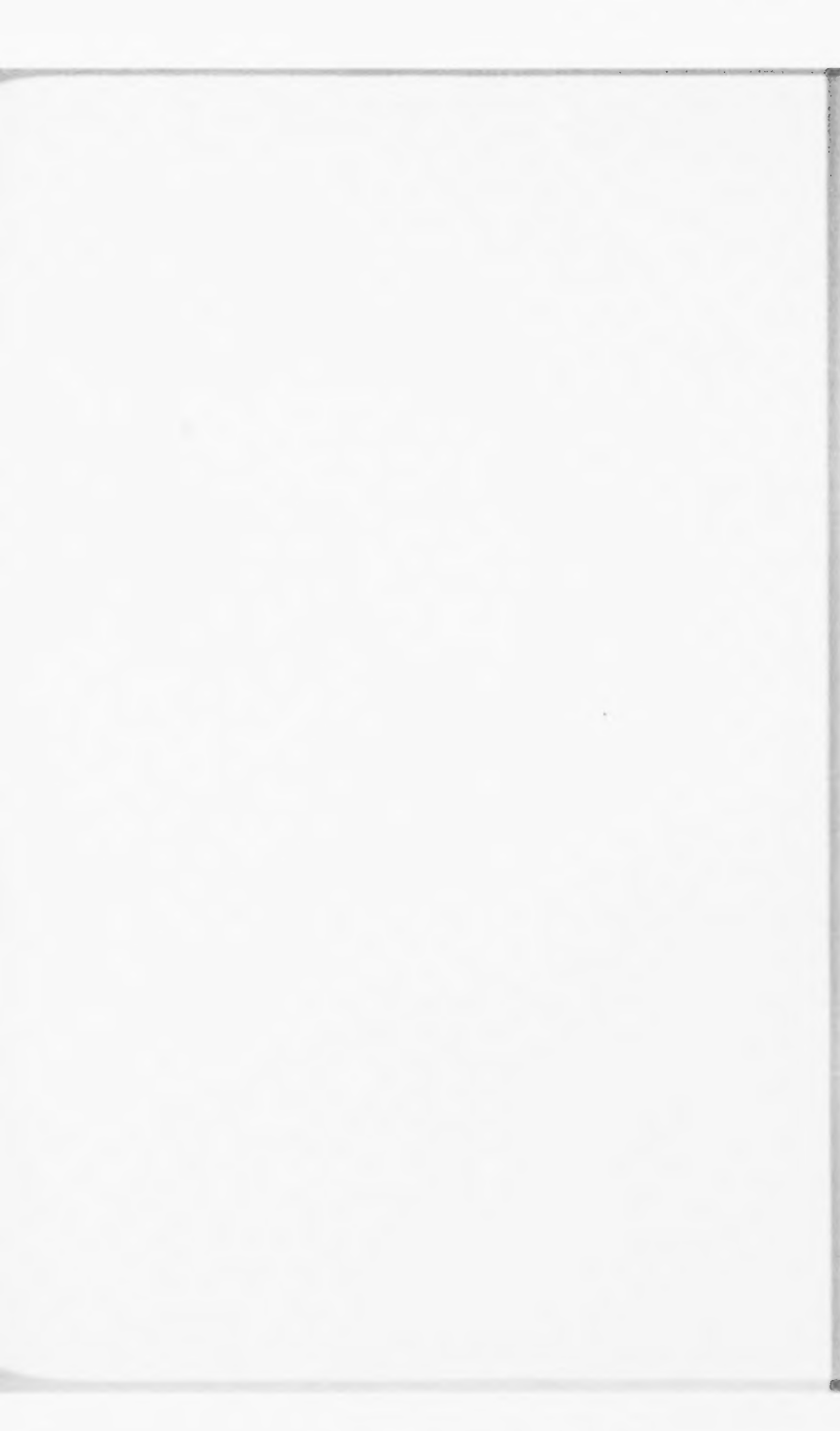
Respondents believe it appropriate here to quote Wool-
sey, District Judge, in **Radio Corporation of America v.
Decca Records**, 51 F. Sup. 493, l. c. 497, for his language
also correctly characterizes the plaintiff here. He said:

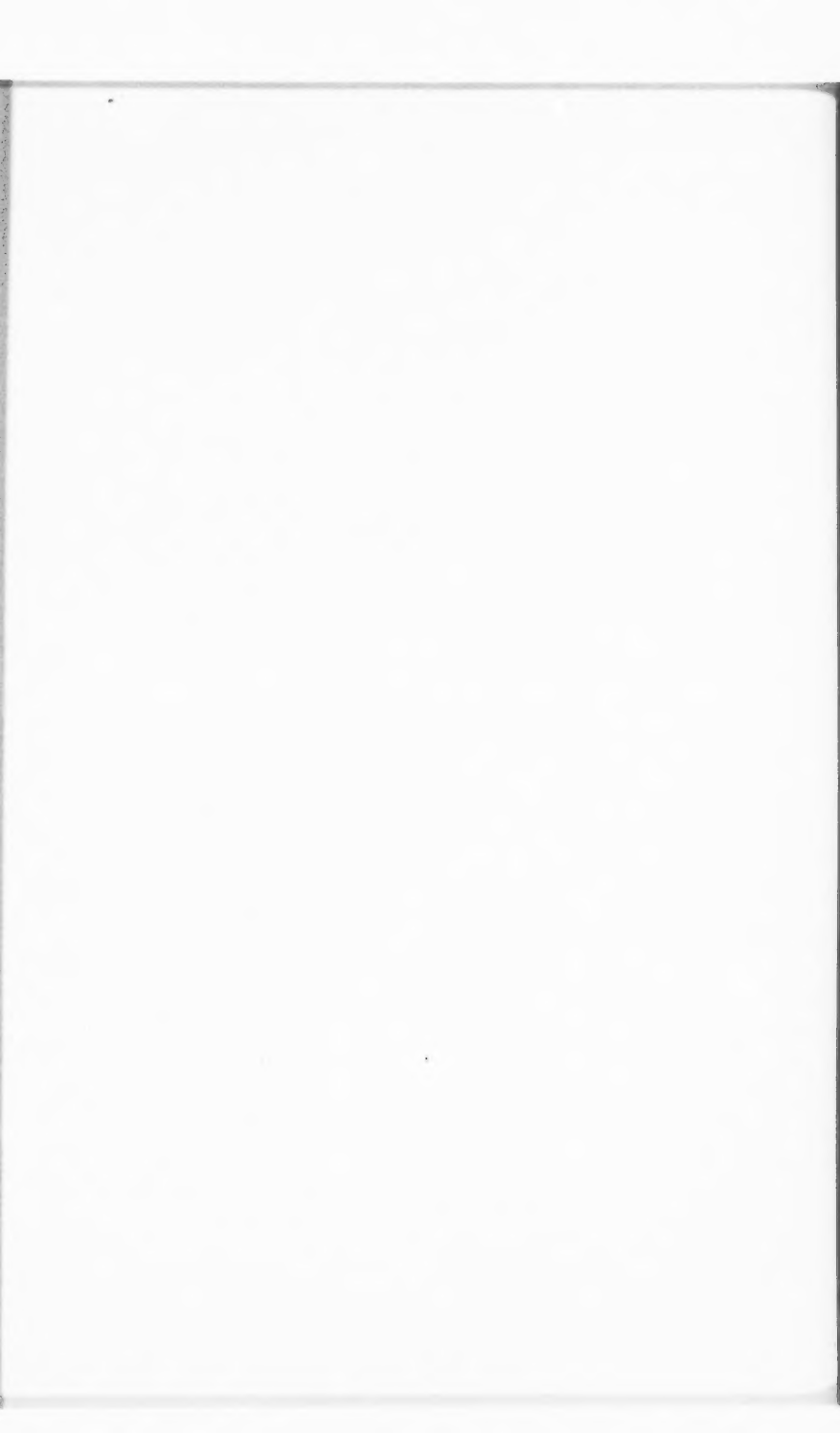
“I am almost persuaded that what the plaintiff dislikes is not what it is pleased to call ‘unfair competition,’ but is any competition at all.”

Respondents respectfully submit that the petition for writ of certiorari should be denied.

Respectfully submitted,

OLIVER T. REMMERS,
Boatmen's Bank Building,
St. Louis, Missouri,
Counsel for Respondents.





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U.S. SUPREME COURT OF THE UNITED STATES

FILED

AUG 20 1945

CHARLES ELMORE BROPLEY
CLERK

IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1945.

No. 151.

THE SEVEN UP COMPANY,
Petitioner,

v.

CHEER UP SALES COMPANY OF ST. LOUIS, MISSOURI,
a Corporation, AMERICAN SODA WATER COMPANY,
a Corporation, and ORANGE SMILE SIRUP
COMPANY, a Corporation,
Respondents.

PETITIONER'S REPLY BRIEF.

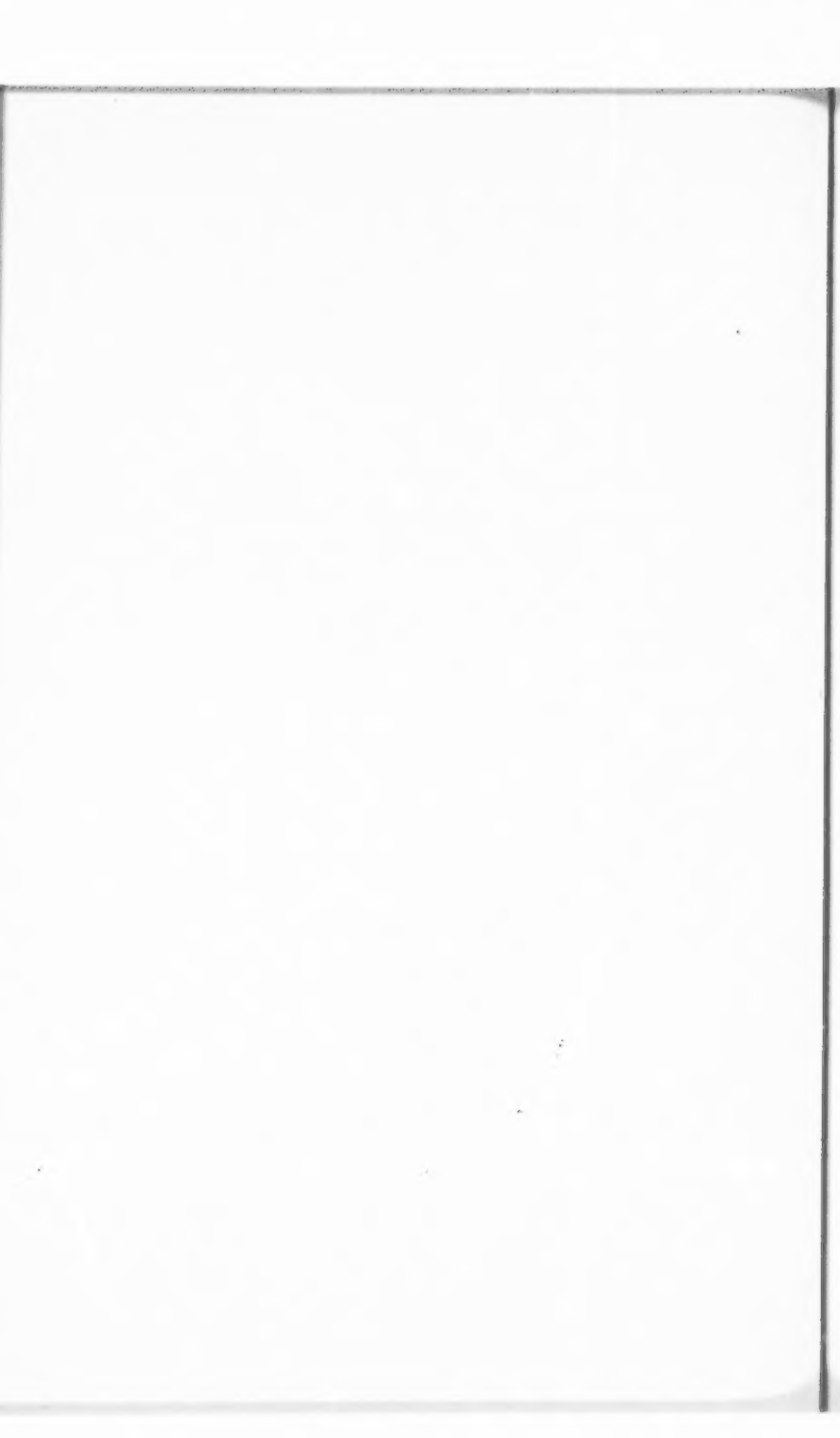
FRANK Y. GLADNEY,
JOHN H. CASSIDY,
Counsel for Petitioner.

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a Corporation, and ORANGE SMILE SIRUP
COMPANY, a Corporation,
Respondents.

PETITIONER'S REPLY BRIEF.

Foreword.

This case involves two distinct questions: A—the confusing similarity of trade-marks under the federal trade-mark statutes and, B—unfair competition in the general appearance of two competing packages under the common law as announced and interpreted by the courts of Missouri. The grounds for the petition are that a question of federal law of public importance is involved which

should be settled by this court, that the said federal question has been decided in a way probably in conflict with an applicable decision of this court, and that the question involving unfair competition has been decided in a way in conflict with an applicable local decision. Respondents' brief apparently fails to distinguish between the two questions involved, and the separate sources of law by which they are governed. Respondents do not challenge petitioner's statement of the case, nor do they challenge petitioner's statement of the questions presented, apparently conceding that petitioner's statement of the questions is accurate and complete.

Reasons Relied on for Granting the Writ.

I.

As to the importance of the question of federal law involved, respondents state that "the point has been ruled on repeatedly by this court and settled by the uniformity of the decisions," citing six Supreme Court decisions, but in no one of which is the question involved. In no one of these cited cases was there involved the question of infringement of a registered mark comprising two arbitrary words or parts.

A. On the statement that the decision is in conflict with applicable decisions of the Court of Customs and Patent Appeals, petitioner had cited (Petitioner's B., pp. 9, 10) six cases which seem to be perfectly in point. Respondents mention three of these cases and attempt to distinguish them by differences in details and ancillary facts, while failing to mention the other three. This course of decisions by the Court of Customs and Patent Appeals in the six cases shows a clear conflict. Respondents' brief, page 6, counters with the mention of a single case involving *Vitamiles* and *Vitabuild*, although it is clearly apparent

that the case cited is not applicable. The common part of the mark, *Vita* was descriptive and not arbitrary. The assertion in petitioner's brief, page 9, that the Court of Customs and Patent Appeals has followed a course of decision without exception for a period of at least fifteen years is therefore not successfully challenged. That court has uniformly followed a conception that it is not permissible in the case of a registered mark comprised of two arbitrary words or parts to adopt and use on directly competitive goods another two-word mark, reproducing one of such arbitrary words in conjunction with a substitute for the other one, in a manner and form so that in the two marks the reproduced word occupies the same relative position.

B. Respondents do not challenge petitioner's statement that the particular facts here presented exemplify a broad pattern of imitation, nor that the use of a mark comprising two words is extensive.

C. As to the effect of the decision on the protected scope of American trade-marks used in foreign commerce, respondents wholly agree with petitioner. They say (page 12): "It is therefore clear that the trade-mark rulings of the courts of the home nation of the product will be recognized in the other nation's signatories to the convention."

That is to say, the decision will not only have the effect as a precedent in this country, but under trade-mark treaties will entail a like effect in foreign countries; further such effect will obtain not only in the instance of 7 *Up*, but also in the case of every other American mark comprised of two arbitrary words. In short, such two-word marks of foreign origin are protected at home and abroad, while such American marks are open to be pirated both at home and abroad. Thus in respect to the protection internationally accorded marks of this character, the law of the

decision reduces the United States to the anomalous status of the least favored nation.

This resulting effect of the decision is emphasized by the long list of cases cited by respondents (pp. 14 to 20). For, the industry of counsel has not sufficed to adduce a single case involving a mark comprised of two arbitrary words which was held to be not infringed by a similar mark in which was reproduced one of such arbitrary words. In each case cited by respondents the reproduced word was descriptive, geographical or otherwise *publici juris*. It is not claimed that *Up* applied to a soft drink is other than arbitrary and fanciful.

The undisputed adverse and discriminating effect of the decision upon American marks in foreign commerce, without more, should induce the grant of the writ.

D. Respondents do not challenge or otherwise comment upon the importance of the decision to petitioner, the common practice of petitioner's competitors in using the same methods of infringement, and the interest to petitioner's bottlers, over 400 in number, whose businesses are independently owned and operated but who are dependent upon the integrity of petitioner's trade-mark as the foundation of their trade.

E. Respondents' brief does not touch upon the interests of the public in being free from astute deception in its casual purchases of inexpensive articles for immediate consumption.

II.

On the conflict with *Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19, 33, respondents confuse the issues by mixing one separate question decided by the court in that case, and relied upon here, with several other issues in that case. The court there decided independently of all other questions that *Hunyadi Matyas* was an infringe-

ment of *Hunyadi Janos*. That set of facts is certainly parallel with those in the question whether *Cheer Up* is an infringement of *7 Up* or *Seven Up*.

III.

On the ground that a question of local law, that of unfair competition, has been decided in a way in conflict with *McCann v. Anthony*, 21 Mo. App. 83, respondents assert, page 2, that "no local law is involved." Such a statement obviously is erroneous. Respondents make no contention that *McCann v. Anthony*, *supra*, has been overruled or modified. An examination of that case will disclose that the two cases are parallel notwithstanding respondents' assertion that it has no application here. They make that assertion "only because the trade name of the defendant there was not involved." That fact has no bearing on the applicability of the case which was directed to the general appearance of the package and the specific holding that a competitor's package similar in general appearance will not be excused merely because the general combination can be broken by changing the background color.

The three cases cited by respondents, page 3, as supporting respondents' position are not in point in any respect. None of them involved unfair competition based upon general appearance of packages.

Comments on Respondents' Statements.

Respondents have made a misstatement, page 4, where it is said that the District Court and the Court of Appeals "have held that the dominant characteristic of petitioner's label is the numeral '7' and 'Cheer' the dominant word in respondents' trade name." There is no such holding in either the Findings of Fact of the District Court, or the decision of the Court of Appeals.

Respondents attempt (page 9) to dispute petitioner's statement that there is not a single finding of fact of the trial court, nor a single conclusion of the Circuit Court of Appeals, which is based on conflicting testimony. They refer to controversies concerning ancillary facts, but it is not shown that these controversies relate directly or indirectly to any finding or conclusion of the District Court or the Circuit Court of Appeals; nor do they show that such a controversy arose because of conflicting testimony or that any findings were resolved between such testimony.

On the question of unfair competition, to assert that the two packages are not deceptively similar in general appearance would be to close the eyes to an obvious fact and is not attempted by respondents. They (page 10) try to circumvent this fact, as did the District Court and the Circuit Court of Appeals, by first withdrawing the green bottle from the combination and then asserting that what is left would not be deceptively similar. That is precisely what cannot be done under the applicable decision *McCann v. Anthony*, 21 Mo. App. 83.

New Matter.

The conflict with the Court of Customs and Patent Appeals and the Patent Office tribunals, is shown by the opinion in Opposition proceeding, *The Seven Up Company v. Wagner*, appearing in the appendix hereto. While that decision was rendered June 15, 1945, a few days before the filing of the present Petition, through either an error in the Patent Office or a failure in the mails, The Seven Up Company never received it in usual course but first learned of it by fortuitous circumstances on July 11, 1945. Hence the opinion or its existence was unknown to this Petitioner when it filed its petition in this court.

The opinion holds that *Thumbs Up* is deceptively similar to *Seven Up* and *7 Up*. It was rendered in the face

of the decision of the Circuit Court of Appeals for the Eighth Circuit, which was diligently presented through brief and oral argument by the applicant Wagner, and upon a concession by Opposer, The Seven Up Company, that the case involving *Thumbs Up* could not be distinguished from the one involving *Cheer Up*. The refusal of the Patent Office to follow the decision of the Court of Appeals in the present case is shown by an omission of any mention of it.

On the other hand the Patent Office relies upon *Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19, and confirms petitioner's suggestion that the opinion of the Circuit Court of Appeals is in conflict with that applicable decision.

The Patent Office decision demonstrates the public importance of the federal question (A) presented in the petition. The settlement of a direct conflict between the courts and the administrative tribunals on the same recurring question is essential.

Respectfully submitted,

FRANK Y. GLADNEY,
JOHN H. CASSIDY,
407 North Eighth Street,
St. Louis 1, Missouri,
Counsel for Petitioner.



APPENDIX.

Final Hearing
May 16, 1945.

Paper No. 26

HSM:EM

In the United States Patent Office

Opposition No. 23,336

The Seven Up Company

v.

Wagner

Mailed
June 15, 1945

Application No. 449,594, Filed December 18,
1941, Published April 11, 1944

Fruit Preparation for Flavoring Ice Cream, etc.

Mr. John H. Cassidy for The Seven Up Company.

Messrs. C. A. Snow & Co., and Mr. Emory L. Groff for
Wagner.

This is an opposition in which each of the parties has
filed a brief and was represented at final hearing. Each
of the parties has introduced stipulated testimony in lieu
of depositions.

The allegations contained in the notice of opposition relate to only the confusion in trade clause of Section 5 of the Act as a statutory ground for negating the right of registration claimed by the applicant.

Applicant seeks registration of the notation "Thumbs Up" as applied to "fruit preparation for flavoring ice cream, said preparation including melons and fruits, other than citrus fruits, cut into small pieces and mixed with their juices and nuts and syrup."

The opposer relies on some five registrations for the notations "Seven Up" and "7 Up" alone and together with certain designs as applied to a carbonated, nonalcoholic, noncereal, maltless beverage sold as a soft drink and flavors used in making the same.

[Here follows a discussion of alleged priority.]

* * * * *

The examiner is of the opinion, therefore, that in view of the somewhat indefinite and contradictory nature of applicant's record that he is not justified in concluding that applicant has had such prior continuous use as to entitle applicant to be held the prior user as between the parties. On the contrary, the examiner is of the opinion that the statutory evidence afforded by the registrations on which opposer relies, and ownership of which has been established, indicates that opposer is the prior user as between the parties.

As respects the goods, they appear to be specifically dissimilar. Applicant's product is a fruit and nut preparation used for flavoring ice cream, whereas opposer's product is a flavoring extract used in making soft drinks. Despite the specific differences, however, the goods of the parties are deemed to be very closely related in use and in trade appeal. Both are flavoring preparations used in flavoring products normally sold in soda fountains to the same customers for similar uses. It is the examiner's

opinion that by reason of this fact they are so nearly related in trade appeal as to constitute goods of the same descriptive properties within the meaning of the Trade-Mark Act.

As respects the marks, both are two-word notations wholly arbitrary in nature, having in common the word "Up." True they differ in the first word in each notation, but it seems to the examiner that where, as here, the goods are relatively inexpensive, purchased by all classes of customers and consumed in use the marks bear such near resemblance as to be likely to lead to confusion in trade.

As stated in the case of *Saxlehner v. Eisner & Mendelson Company* (93 O. G. 940; 179 U. S. 19; 1900 C. D. 362): "It is not necessary to constitute an infringement that every word of a trade-mark should be appropriated. It is sufficient that enough be taken to deceive the people in the purchase of a protected article."

Accordingly, the notice of, opposition is hereby sustained and it is further adjudged that the applicant is not entitled to the registration for which it has made application.

Limit of appeal: July 16, 1945.

A. D. Bailey,
Examiner of Interferences,
Room 2099-B.

June 15, 1945.